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Re Application Of: Stephen JOHNSON et al.

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/804,074	March 13, 2001	Mahammad A. Siddiqi	24257	2154	9099

Invention: **SYSTEM AND PROCESS FOR NETWORK COLLABORATION THROUGH EMBEDDED ANNOTATION AND RENDERING INSTRUCTIONS**

COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:  
November 3, 2006

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Dated: November 3, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Board of Patent Appeals and Interferences

In re the Application of

Stephen Johnson et al.

Group Art Unit: 2154

Serial No.: 09/804,074

Examiner: Mohammad A. Siddiqi

Filed: March 13, 2001

For: A SYSTEM AND PROCESS FOR NETWORK COLLABORATION  
THROUGH EMBEDDED ANNOTATION AND RENDERING  
INSTRUCTIONS

**APPEAL BRIEF**

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**I. Real Party in Interest**

The real party in interest is the assignee of the inventors, ePlus Inc., a public company of Delaware having a principal address of 13595 Dulles Technology Drive, Herndon, VA 20171-3413.

**II. Related Appeals and Interferences**

There are no related appeals or interferences known to Appellants, Appellants' legal representative or the assignee, which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

**III. Status of Claims**

This is an appeal from the Final Rejection of claims 1-14 and 16-65, all of which have been finally rejected and are all under appeal. Claim 15 has been canceled without prejudice or disclaimer.

**IV. Status of Amendments**

A Final Rejection was mailed April 7, 2006 in response to an amendment filed on December 28, 2005. An Amendment under 37 C.F.R. §1.116 was filed on July 7, 2006, resulting in an Advisory Action being mailed on August 4, 2006, indicating that the Amendment under 37 C.F.R. §1.116 was entered into the record to remove certain informalities cited in the Final Office Action, but this Amendment did not place the application in condition for allowance. No further Amendments have been filed.

**V. Summary of Claimed Subject Matter**

Concise Explanation of Independent Claims 1, 17, 23, 41 and 53:

Claim 1 recites a computer-implemented method of network collaboration through embedded annotation and rendering instructions to permit client collaborators to generate, transmit and render collaborative content between collaborators without installing application specific software at the client end. The method comprises the steps of generating by an originator client workstation 50 (Fig. 2, specification at page 13, paragraph [46], 4th line in paragraph) a collaborative content (Fig. 6, items 40, 41, 42, page 13, paragraph [46], lines 4-5) including a base document (Figs. 6 and 8 without items 40, 41, 42 thereon, paragraph [52], lines 1-2) having a document identifier (Fig. 5, Listing 1, specification page 18, paragraph [60], lines 4-5) that identifies a location of content; and at least one collaborative content element (Fig. 6, items 40 or 41 or 42, specification at page 19, paragraph [63] lines 3-4) that comprises at least one annotation (Fig 6, items 40, 41, 42, specification at paragraph [27], line 7) therein and rendering instructions (Fig 5, Listing 2, page 18, paragraph [60], lines 1-4 and paragraph [61], lines 1-3) therefore to annotate the base document (Figs. 6 and 8 without items 40, 41, 42, page 15, paragraph [52], lines 1-2) by embedding the annotation and instructions as an encoded representation of collaborative content (specification at page 18, paragraph [60], lines 1-4 to page 19, paragraph [62], line 3, and Figure 5, Listing 1 and Listing 2) and forwarding the collaborative content to a server for execution (specification at page 17, paragraph [58], first three lines of paragraph, and Figure 2). The server transmits the base document and renders the collaborative content element into an HTML format that instructs the browser how to display the annotations on the base document (specification at page 17, paragraph [58], particularly 6<sup>th</sup> line through end of paragraph, and page 20 at paragraph [70], lines 1-3, and Figure 2, server 53 and originator client workstation 50). The collaborative content is then provided to the originator client workstation for display (specification at page 19, paragraph [62], last three lines of

paragraph, see Figure 1 for collaborative content displayed on element 22, after being rendered by the server 40, specification at page 11, paragraph [39], line 1).

Claim 17 recites a network collaboration tool using embedded annotation and rendering instructions comprising a web browser software for displaying a collaborative content in accordance with rendering instructions therefore, collaborative content including a base document (Fig. 6, without items 40, 41 or 42, page 15, paragraph [52], lines 1-2) having a document identifier (Fig. 5, Listing 1 URL, specification at page 18, paragraph [60], lines 4-5) that identifies a location of a content of said base document and at least one collaborative content element (Figures 6 and 8, items 40, 41 or 42 ) having an embedded annotation in the document identifier (specification at page 18, paragraph [60], line 1, to page 19, paragraph [62], line 3, and Figure 5, Listing 1 and Listing 2). A graphical collaboration tool (specification at page 7, paragraph [28], line 4) for generating at least one collaborative content element (Figure 6, items 40, 41 and 42) on the collaborative content displayed in the web browser software (specification at page 7, paragraph [28], line 3) and transmitting the at least one collaborative content element and rendering instructions therefore (specification at pages 11-12, paragraph [41] and specification at page 18, paragraph [60], line 1 to page 19, paragraph [62], line 3 and Figure 5, Listing 1 and Listing 2) to a server processor 53. The server 53 (Figure 2, item 53, specification at page 13, paragraph [47], lines 1-3, Figure 4 item 84, specification at page 15, paragraph [51], lines 11-14) receives at least one generated collaborative content element and rendering instructions therefore and renders the annotations into an HTML format that instructs the browser how to display the annotations on the base document in accordance with the received rendering instructions, and generates a combined collaborative content including the base document and code for received collaborative content element and embedded annotation in the document identifier (specification at page 14, paragraph

[50], first four lines, Figure 7, step 75 performed by server 53) thereof for display by said web browser software (specification at page 14, paragraph [49], Figure 7, step 76 by display 22).

Claim 23 recites a system for network collaboration using embedded annotation and rendering instructions. The system allows collaboration using embedded annotation and rendering instructions, and includes a processor 14 (Fig. 1, specification at page 10 paragraph [38], and page 11 at paragraph [40], last 6 lines of paragraph) for receiving and transmitting data (specification at pages 11-12, paragraph [41], and Fig. 1 communication interface 28 and bus 12). A memory 16 (Figure 1, specification at page 11, paragraph [41]) is coupled to the processor 14. The memory 16 has stored therein sequences of instructions (specification at page 11, paragraph 40, last six lines) which, when executed by said processor 14, cause the processor 14 to generate a collaborative content (Figures 6 and 8, items 40, 41 or 42) including a base document (Figs. 6 and 8 without items 40, 41 or 42, page 15, paragraph [52], lines 1-2) having a document identifier (Figure 5, URL in Listing 1 specification at page 18, paragraph [60], lines 4-5) that identifies a location of content of said base document, and at least one collaborative content element having an embedded annotation in said document identifier and rendering instructions therefore (specification at page 18, paragraph [60] line 1, to page 19, paragraph [62], line 3 and Figure 5, Listing 1 and Listing 2), to render the collaborative content in accordance with rendering instructions (specification at page 17, paragraph [58], particularly 6<sup>th</sup> line through end of paragraph, page 20, paragraph [70], lines 1-3 and Figure 2, server 53 and originator client workstation 50).

Claim 41 recites a client system for network collaboration. A client system for network collaboration comprises a collaborative content including a base document (Figs. 6 and 8 without items 40, 41 or 42, specification at page 15, paragraph [52], lines 1-2) having a document identifier (Fig. 5, Listing 1, specification page 18, paragraph [60], 4-5 lines) that identifies a location of content

of said base document. At least one collaborative content element (Fig 6, items 40, 41, or 42, specification at page 19, paragraph [63], lines 3-5 of paragraph) having an embedded annotation in the document identifier (Figure 5, Listing 1 and Listing 2, specification at page 18, paragraph [60], lines 4-5), and rendering instructions therefore (specification at page 18, paragraph [60], line 1, to page 19, paragraph [62], line 3, and Figure 5, Listing 1 and Listing 2). A graphical collaboration tool (specification at page 16, paragraph [53], lines 1-6, Figure 6, item 43, 43A-43E) for generating, rendering said collaborative content in accordance with said rendering instructions, and transmitting said base document and collaborative content with said rendering instructions embedded in said document identifier therein, wherein said graphical collaboration tool is downloaded from a server (specification at page 12 paragraph [43], last two lines, and page 20, paragraph [69], lines 1-3).

Claim 53 recites a server system for network collaboration that includes a collaborative content (Fig. 6, items 40, 41, 42, specification at page 13, paragraph [46], lines 3-4) including a base document (Figure 6, without items 40, 41, 42, page 15, paragraph [52], lines 1-2), having a document identifier (Fig. 5, Listing 1, specification at page 18, paragraph [60] lines 4-5) that identifies a location of a content of said base document and at least one collaborative content element having a first embedded annotation to said document identifier as an encoded representation of said collaborative content, and first rendering instructions therefore (specification at page 18, paragraph [60], line 1 to page 19, paragraph [62], line 3 and Figure 5, Listing 1 and Listing 2). A server 53 processor responds to a user request, wherein the user requests the base document transmitted by the server along with collaborative content as the embedded annotation transmitted in HTML format by the server (Figure 2, item 53, specification at page 13, paragraph [47], lines 1-3, Figure 4 item 84, specification at page 15, paragraph [51],



lines 11-14). A graphical collaboration tool (specification at page 16, paragraph [53], lines 1-6, Figure 6, item 43, 43A-43E,) and the collaborative content including an added collaborative content element having a second embedded annotation to said document identifier as an encoded representation of said added collaborative content, and second rendering instructions therefore, and said collaborative content including a modified collaborative content element having a third embedded annotation to said document identifier as an encoded representation of said modified collaborative content, and third rendering instructions therefore (specification at page 14, paragraph 14, lines 1-20 and Figure 7, steps 71-79 in particular).

**VI. Grounds of Rejection to be Reviewed on Appeal**

I. Claims 1-14, 15-58, 59 and 60-65 are finally rejected under 35 U.S.C. §103(a) over Eintracht et al. (U.S. 6,687,878 herein after "Eintracht" in view of Rivette et al. (U.S. 6,877,137 herein after "Rivette").

**VII. Argument**

**(a) The of Rejection of independent claims 1 and 23 over the combination of Eintracht and Rivette fails to establish a *prima facie* case of obviousness and Appellants have submitted evidence not considered by the Examiner**

It is respectfully submitted that claims 1 and 23 would not have been obvious to a person of ordinary skill in the art over the combination of Eintracht and Rivette, and this ground of rejection is traversed for the reasons indicated herein below.

It is alleged in the Final Rejection dated April 7, 2006 that instant claims 1 and 23 would have been obvious over the combination of Eintracht and Rivette because Eintracht allegedly

discloses a computer-implemented method of network collaboration through embedded notation and rendering instructions to generate, transmit, and render collaborative content, including the generation by an originator client workstation a collaborative content including a base document having a URL (Uniform Resource Locator) document identifier that identifies the location of a content of the base document, and at least one collaborative content element.

**(i) The combination of Eintracht and Rivette fails to make a *prima facie* case of obviousness under 35 U.S.C. §103(a) because the combination fails to meet any of the criteria exemplified by *In re Vaeck* and its progeny**

It is well settled law (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) and stated in MPEP §2142 (as well as in §2143.03) that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or combination of references must teach all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

**(ii) There has been no motivation or suggestion provided to combine Eintracht and Rivette**

The Final Rejection dated 8/4/06 fails to provide any evidence of some suggestion or motivation, either in the references themselves or in the knowledge generally available in the art, to combine the teachings of Eintracht and Rivette.

It is stated in the Final Rejection on page 4 that the motivation to combine Eintracht and Rivette would have been for developing a system for enabling the organization and recordation of

a person or group's thinking, work product and data objects collected or generated during a project or task.

However, the above "motivation" is a general description of the operation of the Applicant's invention, and is not a reason that a person of ordinary skill in the art would have gleaned from the references and any general knowledge in the art to combine the references. As both Eintracht and Rivette permit users to write notes that can be associated with an original document on a display, Applicant specifically notes that the Examiner has failed to specify what motivation found in the references or known in the art at the time of the invention would cause the artisan to combine the references such that present claims 1 and 23 would have been obvious? The mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (*In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), and the desirability cannot come from Applicant's disclosure and claimed invention.

**(iii) There is no reasonable expectation of success found in the prior art**

The combination of Eintracht and Rivette lack any reasonable expectation of success without being based on Applicant's disclosure. The references are completely silent in with regard to Applicant's embedding and annotation technique to the base document identifier (typically a URL).

**(iv) The combination of Eintracht and Rivette fails to teach all the claim limitations**

MPEP §2143.03 states that in order to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1984). It is respectfully submitted that the combination of Eintracht and Rivette fails to disclose, suggest or provide any motivation such that

any of the present claims would have been obvious to a person of ordinary skill in the art at the time of invention.

For example, the combination of Eintracht and Rivette fails to disclose or suggest, or provide motivation to the artisan to obviate the recitation of the generating step in present claim 1 and the instructions causing the processor to generate in claim 23, particularly by an originator client workstations *at least one collaborative content including a base document having an identifier that identifies a location of content of the base document and at least one collaborative element having an embedded annotation therein and rendering instructions therefore so as to annotate the base document.*

It is admitted in the Final Rejection (page 3, paragraph number 5 that "**Eintracht explicitly does not disclose**" that the collaborative content element "comprises at least one annotation therein and rendering instructions therefore so as to annotate said base document by embedding at least one annotation and instructions therefore as an encoded representation of collaborative content and forwarding the collaborative content to a server for execution rendering by a server said collaborative content element to said base document in accordance with rendering instruction, and providing said collaborative content to said originator client workstation for display" (emphasis in boldface added by Applicants). However, Rivette in combination with Eintracht, allegedly provides this lack of explicit disclosure. Applicants respectfully disagree for the following reasons:

Applicants respectfully submit that in the generating step in present claim 1 *that the base document is annotated by embedding both the collaborative content and the rendering instructions in an HTML format into an identifier of the base document, typically in a Uniform Resource Locator (URL).* Herein below is an explanation of such a process.

For example, Figure 5 shows a sample of the URL for the base document and the encoded collaborative content and rendering instructions as produced by a preferred embodiment of the invention (Listings 1 and 2) and an alternate implementation in XML language (Listing 3). The collaborative content that can be viewed with the original document is shown, for example, in Figure 8. The base document has the additional collaborative content indicated by circle 40, arrow 41 and box 42 containing the text. The encoding for the items 40, 41 and 42 come from Listing 2 and are embedded to the URL in Listing 1.

In other words, the recitations in present claim 1 regarding "annotate said base document by embedding said at least one annotation and instructions therefore as an encoded representation of collaborative content" (as well as a similar recitation in claim 23) is shown, for example, by Listing 2 in Figure 5. Listing 2 contains the complete encoding including the URL part one (Listing 1) followed immediately by URL part two (Listing 2). URL part one (Listing 1) contains the base document or content identifier, its location on a document repository, e.g. persistent base document storage 55, and detailed viewing information. The detailed viewing information specifies the zoom level and position of the view on the particular drawing. Part one (Listing 1) of the URL refers to the base document, and this portion is not altered by the collaboration process.

Still referring to the example in Figure 5, the second listing (Listing 2) contains the annotations which are embedded as an encoded representation to the first listing (Listing 1) for the base document identifier and sent to the server for processing. The server retrieves the base document identified in the URL and transmits the base document to the client with the encoded representation of the collaborative content in an HTML format, so that the browser is instructed exactly how to render the annotations on the base document. In this example, the content includes three collaborative elements: a red circle, a red arrow, and a text area containing the text: "this is a

collaborative element". Rendering instructions may include but are not limited to, the location on the base document wherein the circle/arrow/text box are all placed. In the example, the complete URL, as specified by parts one and two (Listings 1 and 2) is as follows:

```
http://localhost.dpr/ds.dpv/00016J/1/123??dpv=bt7dc0dm1dn1do1eOoh5i6800j  
4400k25610n2441o25p1r0s33stOttOw7x896xm0xt7y64ym0yt5&DPDB_ID  
NT-GIBBS/00016j/1&DPDB_SH=04131&_RCR=circle|240|2542|2565|3248|1  
&_RAR=arrow|3544|312|2982|2701|1&_RTX=this%20is20is%20a%20collabor  
ative%20element|3544|3058|5229787|13176|1?,448
```

The URL is a link to the server. The text of the URL may be transmitted from workstation to workstation, but, when the URL is activated at a client (e.g. by clicking of cutting and pasting in a browser address bar), the request goes to the server for processing. The recipient client workstation can retrieve the actual base document identified by the URL, and activation of the URL causes the processor 53 to transmit the image of the base document and the HTML code for the annotations, so that the recipient client workstation receives the base document and the HTML code representing Listing 2 which instructs When the listing above is sent to a recipient client workstation, the client workstation can activate to receive the actual base document from the server and the annotations and instructions in HTML representing Listing 2 which has been rendered as HTML (hypertext markup language) by the process server 53 before being sent to the recipient client workstation along with the base document so that the client browser can display the base document with the collaborative content. The resulting HTML provides the instructions to the recipient client workstation in shorthand to improve performance and instructs the browser in the recipient client workstation exactly how the annotations are displayed in relation to the base document.

Now again referring to Figure 8, this shows the display resulting from the URL introduced

in Figure 5. It should be noted that the circle 40, arrow 41 and box 42 are all not part of the base document but are shown on the display because an encoded Listing 2 is embedded into the base document identifier of part one (Listing 1) and subsequently transmitted (image of the base document and the HTML shorthand of the annotations) to a client for display.

One advantage of the present invention is that the client workstations do not need any software installed other than an internet browser and an embedded scripting language, and the only application software needs to be installed only on the service processor 53. The method recited by claim 1 permits the collaboration process to be available to any device with an Internet browser and server connectivity, providing a "zero footprint" (specifications, paragraph [60]).

In contrast with present claims 1 and 23, the combination of Eintracht and Rivette fails to disclose, suggest, or to provide motivation to a person of ordinary in the art at the time of invention to annotate a base document and embed an annotation and instructions therefore into a base document. In fact, Applicant respectfully submits that the characterization of Eintracht in the Final Rejection by the Examiner is at best a half-truth because it is stated that "Eintracht explicitly does not disclose" that the collaborative content element "comprises at least one annotation therein and rendering instructions therefore so as to annotate said base document by embedding at least one annotation and instructions therefore as an encoded representation of collaborative content. ..." The whole-truth is that Eintracht neither explicitly nor implicitly, or inherently for that matter, discloses the embedding of one annotation and instructions into the URL of the base document, as to be discussed, *supra*.

In contrast, Eintracht teaches a client software application to render a document and its annotations as a layered display, which is distinguishable from embedding an encoded representation and rendering instructions to annotate a base document as recited by present claim 1.

Also, the present claimed invention (see, for example, paragraph [64] on page 19, specifically states that no client application software is required, other than a web browser and an embedded scripting language.

In addition, present claims 1 and 23 distinguish over the combination of Eintracht and Rivette because Eintracht teaches storing the documents and notes in separate databases at a server, retrieving them separately, and transmitting them in separate data streams to a client software application, where they are layered for display. Eintracht discloses at column 2, lines 50-55 that:

In accordance with the invention, **the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document.** At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each (emphasis in boldface added).

In view of the above, it is counter-intuitive to the teachings of Eintracht to credit the reference with even implicitly disclosing that there is an embedding of the annotations and rendering instructions to the base document. Embedding annotations and rendering instructions is contrary to the operation of Eintracht.

Furthermore, Eintracht discloses at column 4, lines 14-38 that:

There is also provided in accordance with the present invention method of annotating documents, the method comprising the steps of **getting a first request comprising a Universal Resource Locator (URL) associated with a document to be viewed and annotated and transmitting the first request from a client to a server,** sending a first response from the server in response to the first request, the first response comprising the document type of and a representative of the requested document, getting a second request comprising a document note URL corresponding



to the notes associated with the document and sending the second request from the client to the server, sending a second response from the server in response to the second request, **the second response comprising one or more notes locally on the client such that both are viewable simultaneously...** (emphasis added).

Thus, it is clear from the above that Eintracht transmits a requested document in a first response and then possibly the notes in a second response. The two serial transmissions (document on sent on one Data Stream, notes on another Data Stream) does not disclose or suggest the generating step in present claim 1 (or the generation in claim 23) including embedding at least one annotation and instructions therefore in order to annotate a base document. In fact, **Eintracht discloses that the notes and the documents use independent data streams:**

The Notes Server **generates two independent HTTP streams:** the first stream is for the displayed image **and the second stream is for the annotations** (Eintracht at column 9, lines 56-58, emphasis in boldface added).

Figure 7 of Eintracht provides flow chart showing that at step 140 the document is first request and at step 144 a note buffer is first prepared and the notes are sent and displayed by the user (Eintracht at column 14, line 48 to column 15, line 23).

Furthermore, Eintracht even discloses that the rendering instructions are kept separate from the annotations (as well as being kept separate from the document). Eintracht discloses at column 7, lines 59-65 that the **"the location associated with a note is a called a Note Anchor and is kept separate from the annotation data itself."** Thus, not only does Eintracht fail to disclose or suggest annotating the base document by embedding the annotation and the rendering instructions therefore to annotate a base document, but also keeps the annotation data itself separate from the rendering instructions by using a Note Anchor to keep the location information separate from the data itself. This layout contrasts, for example, with Listing 2 of the claimed

invention that shows annotations and instructions therefore embedded, with Listing 1 being the entire document identifier and Listing 2 the annotations and rendering instructions. Therefore, Eintracht does not disclose any of the steps recited in claim 1.

With regard to Rivette, it is respectfully submitted that similar to Eintracht, Rivette fails to disclose or suggest that the base document is annotated by an encoded representation of the collaborative content and rendering instructions therefore are embedded. Thus, the combination of Eintracht and Rivette fails as a combination of teachings, to disclose or suggest the present claimed invention.

Rivette discloses a system and method of manipulating notes linked to Web pages, and of manipulating the Web pages. Rivette enables a user to select a portion of a Web Page stored at a web site, create an annotation and link the annotation stored in a notes database 508 to the selected portion. **Rivette does not disclose a generating step including annotating a base document by embedding at least one annotation and rendering instructions.**

**For example, Rivette, alone or in combination with Eintracht, fails to disclose or suggest to an artisan that the URL of a base document is annotated with collaborative content and rendering instructions, such as in Listing 2 of Figure 5 of the present invention. Rivette permits one viewing a webpage to click on a link to a notes database and jump around and read the notes out of sequence.**

Figure 6 of Rivette shows a computer 602 having a separate notes database 508 and a web page database 509. A hyperlink from web page database 509 to the notes database 508 does not disclose an annotation of a base document with collaborative content and rendering instructions, as is recited in present claims 1 and 23.

In contrast to Rivette, in present claims 1 and 23 the embedding is a combining of the URL

of the base document and the collaborative content (Figure 5 of the present invention shows Listing 2 being a combination of Listing 1 and the collaborative content and rendering instructions).

Furthermore, Applicants refer to the Declaration Under 37 C.F.R. §1.132 that was signed on April 7, 2005 by two experts in the field and addressed in the Office Action mailed July 28, 2005. While the Examiner ignored in its entirety this declarations because he alleged it did not pertain to every single claim, the declaration at page 4 discusses the function of the claimed invention and how its operation is distinguishable from Eintracht. These reasons apply to Rivette as well, particularly the section at page 4 which declares that the claimed invention "combines a URL for a base document with associated collaborative content elements into a collaborative content... ." Present claims 1 and 23 recite in part that there is a rendering by a server of the collaborative content element to the base document in accordance with the rendering instructions, and that the collaborative content is provided to the originator client workstation for display. The rendering of the collaborative content into HTML format, for example to be transmitted to the originator client workstation for display with the transmitted image of the base document.

In the Final Rejection, the Examiner alleges that Rivette discloses at column 7, lines 45-47 that a data object is embedded with a note and instructions therefore. However, Applicants respectfully disagree with the Examiner's allegation that the embedding recited in claims 1 and 23 is met by a data object having a note attached, as in Rivette.

The portion of Rivette (column 7, lines 45-47) is understood by an artisan in the context of, for example, attaching notes to data objects as one can attach notes to an MS Word, WordPerfect, or Excel document (please see Rivette, column 3, lines 38-59).

For example, it is first noted that there is no client-server relationship using MS Word et al.

in the context of Rivette (he is talking about Word being accessed on a personal computer), and thus in Rivette, there is no generating by an originator client workstation of a collaborative content elements that comprises at least one annotation and rendering instructions that is forwarded to a server for execution in accordance with the rendering instructions.

One of the advantages of the present claimed invention over prior art systems such as Eintracht (and/or Rivette) is that the client/originator does not need any software installed other than an internet browser and an embedded scripting language on the client side, and the only application software needs to be installed only on the service processor (specification at page 19, paragraph [64]). Thus, the invention permits a user to be able to view and update collaborative content on items with almost no additional memory or processing power, including PDAs, handheld organizers, cell phones, mobile pagers and Internet appliances to name a few (specification at page 20, paragraph [66]).

Another advantage of the present invention lies in the fact that security is improved as the URL of the base document is sent over the network, which would only be viewable by an authorized user. If the document was transmitted as an email attachment, the document is vulnerable to any breach of email security.

In addition, yet another advantage of the present claimed invention over the prior art is that many email systems have limits as to the size of an email attachment to ensure that the server is not spending excess time processing very large attachments. In the present claimed invention, the sending of the base document identifier and its annotations and instructions (e.g. Listing 1 and Listing 2 in Fig. 5, for example) is a very small by comparison to an attachment, which is also beneficial to less powerful users such as PDA's and cellphones.

Moreover, paragraph [35] (pages 8-9) of the present specification discloses that "[T]he

present invention is a system and process for network collaboration using embedded annotations and rendering instructions to enable collaborators to generate, share or transmit, and render collaborative content over the Internet. Collaborators are able to view, generate, and render the collaborative content **without installing any application software on their computer systems other than a web browser...** (emphasis added in boldface).

Also, the Declaration Under 37 C.F.R. §1.132 (signed April 7, 2005) at page 6, last paragraph, discusses that Eintracht requires a client software application. While Rivette is not mentioned in the Declaration, the Rivette disclosure requires the installation of application software at the client end, including but not limited to one of MS Word, WordPerfect or Excel, to permit a "comment" feature, and the comment is not an encoded representation embedded with the base document and forwarded to a server for execution.

Accordingly, the recitation in present claims 1 and 23 of an encoded collaborative element and rendering instruction that is embedded into a base document identifier and forwarded to a server for retrieval of the base document, which is sent back to the originator client workstation for display along with the annotations transmitted in an HTML format for display is distinguishable from the comment feature, aka data object, disclosed by Rivette, which is executed on the client side and requires application specific software.

For example, in contrast to present claims 1 and 23, Rivette discloses attaching a note to MS Word (or WordPerfect or Excel) that requires a user having a personal computer and a copy of the Word application software on the user's computer, and the note is processed at the user (client side-originator workstation side). The processing of the note disclosed in Rivette clearly contrasts with the recited sub-step of *"forwarding the collaborative content forwarded to the server for execution"* as recited in present claim 1.

To reiterate, the note in Rivette is processed locally and requires application software. An artisan with knowledge of Eintracht and Rivette would not find any disclosure, suggestion, or motivation that would make the claimed generating step and the claimed rendering step obvious in view of the references. Moreover, the Examiner has previously cited column 6, lines 43-52 of Eintracht as somehow providing suggestion to transfer execution from the workstation side to the server. Applicants assert that the aforementioned passage in Eintracht fails in combination with Rivette to provide any specifics that would have made it obvious to a person of ordinary skill in the art at the time of the invention to perform the generating step in present claim 1 including the embedding of annotation, nor to perform the forwarding sub-step. It should also be noted that column 6, lines 41-43 of Eintracht disclose separate data structures are created for the documents and the associated annotations to permit independent management.

In addition, present claim 1 recites in part that an originator client workstation generates the collaborative content including a base document having a document identifier and performs the embedding of the annotation and instructions therefore as an encoded representation of collaborative content, this encoded representation (a.k.a., Listing 2 from Fig. 5) is forwarded to a server for retrieval of the base document identified by the identifying URL, and providing instructions to the browser of the client workstation for displaying the annotations.

Although it is also alleged in the Final Rejection that Rivette discloses rendering instructions at column 8, lines 13 to 30 and column 18, lines 12-24, these pages actually refer to a discussion of providing links to information at another file possibly in another database, as opposed to an annotation and rendering instructions being embedded as an encoded representation of collaborative content, and forwarding the collaborative content to a server for execution.

Rivette discloses at column 13, lines 19-26 that the notes database and/or web pages

database are not necessarily stored within a single computer and that they could be distributed among multiple computers.

Rivette discloses, at best, that there is a linking button embedded (please see Figure 35, step 3512), wherein a notes engine commands an application associated with the Web page to display a linking button to locate a new sub-note.

However, the aforementioned linking button is distinguishable from the claimed invention and does not obviate the embedding of a collaborative element (as opposed to a link to collaborative content) and rendering instructions for executing and viewing the embedded collaborative content as currently claimed.

Accordingly, Applicants respectfully submit that present claims 1 and 23 would not have been obvious to a person ordinary skill in the art in view of Eintracht and Rivette.

It is also respectfully submitted that all of the claims dependent on base claims 1 and 23 are non-obvious at least for the reasons that they depend from one of independent claims 1 and 23, both of which are non-obvious (*In re Fine*, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988)). In addition, some of these claims have an independent basis for patentability. For example, instant claims 2 and 24 include recitations of annotating the collaborative content by adding another collaborative element. In other words, the same or even another workstation adds another collaborative element, which is not taught, suggested, nor is motivation supplied by the combination of Eintracht and Rivette. With regard to claims 5 and 27, the combination of Eintracht and Rivette fails to disclose or suggest, for example that the content element is a symbol, an encoded representation shape or text input element and rendering instructions therefore are embedded so as to annotate the base document. With regard to claim 6 and 28, the combination of Eintracht and Rivette fails to disclose that there is an annotating step comprising a visual cue to

indicate the state of the collaborative content. The combination of references is silent in this regard as well.

Thus, Appellants respectfully request that the Honorable Board reverse the Final Rejection of claims 1-14 and 23-40, and 59-65.

**(b) The Rejection of claim 17 over the combination of Eintracht and Rivette fails to establish a *prima facie* case of obviousness**

Similar to the rejection of claim 1, the Examiner has failed to establish a *prima facie* case of obviousness against independent claim 17 for the following reasons:

(i) **There has been no motivation or suggestion provided to combine Eintracht and Rivette** other than the motivation discussed on page 4 of the Final Rejection and discussed above.

**(ii) There is no reasonable expectation of success found in the prior art**

The combination of Eintracht and Rivette lack any reasonable expectation of success without being based on Applicant's disclosure. The references are silent in regard to a network collaboration tool that generates the collaborative content that is generated and displayed with web browser software and is executed by server.

**(iii) The combination of Eintracht and Rivette fails to teach all the claim limitations**

The Final Rejection dated 8/4/06 lacks some suggestion or motivation, either in the references themselves or in the knowledge generally available in the art, to combine the teachings of Eintracht and Rivette.

It is stated in the Final Rejection on page 4 that the motivation to combine Eintracht and Rivette would have been developing a system for enabling the organization and recordation of a



person or group's thinking, work product and data objects collected or generated during a project or task.

However, the above "motivation" is a description of the Applicant's invention rather than motivation or suggest from the references. As both Eintracht and Rivette permit users to write notes that can be associated with an original document on a display, what motivation found in the references or known in the art at the time of the invention would the artisan glean from the combination of references such that present claim 17 would have been obvious? The mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (*In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)).

With regard to claim 17, the combination of Eintracht and Rivette fail to disclose, suggest, or provide motivation for a network collaboration tool using embedded annotation and rendering instructions such that claim 17 would have been obvious to a person of ordinary skill in the art at the time of invention. For example, the combination of Eintracht and Rivette fails to disclose or suggest a web browser for software for displaying collaborative content including a base document having a document identifier that identifies a location of a content of said base document and at least one collaborative element having an embedded annotation in said document identifier. Eintracht and Rivette does not teach or suggest a base document having a document identifier, nor does the combination teach or suggest the embedding annotation of at least one collaborative content element in the document identifier.

In addition, as the combination of Eintracht and Rivette do not disclose or suggest the server process recited in claim 17 for receiving the generated collaborative content element and rendering instructions therefore, the combination of references also fails to disclose or suggest *the*

*server* rendering the document in combination with the collaborative content element (*annotations*). Eintracht discloses "**at the client side**, the client application layers the annotations over the image" i.e., meaning that the client performs the rendering step not the server.

Again, Applicants note that just because Eintracht states at column 6, lines 43-53, that there is some software that executes on the client side and some that executes on the server side, in no way does this disclosure rise to the level of disclosing or suggesting that the server can render an embedded document, particularly when the only specific discussion in the reference is that at the client side the client application layers annotations over the image. The image in Eintracht is separate from the annotations, and this passage does not suggest an embedded annotation in the URL of an image so the client receives the transmitted base document and annotations in a format such as HTML.

Furthermore, with regard to Rivette, it is first noted that there is no client-server relationship using MS Word et al. in the context of Rivette (he is talking about Word being accessed on a personal computer), and thus in Rivette, there is no generating by an originator client workstation of a collaborative content elements that comprises at least one annotation and rendering instructions that is forwarded to a server for execution in accordance with the rendering instructions. Therefore, the combination of Eintracht and Rivette still fails to disclose or suggest all of the claimed limitations of Applicant's claims.

To reiterate, one advantage of the claimed invention is that it does not need any software installed other than an internet browser and an embedded scripting language on the client side, and the only application software needs to be installed only on the service processor (specification at page 19, paragraph [64]). Thus, the invention permits a user to be able to view and update collaborative content on items with almost no additional memory or processing power, including

PDAs, handheld organizers, cell phones, mobile pagers and Internet appliances to name a few (specification at page 20, paragraph [66]).

Accordingly, Eintracht in combination with Rivette, clearly fails to provide any disclosure, suggestion or provide motivation such that present claim 17 would have been obvious to a person of ordinary skill in the art. In addition, claims 18-22 are also believed to be patentable at least for the reason that they depend from an independent claim that is non-obvious, and because of an independent basis for patentability. For example, with regard to claim 21, the combination of Eintracht and Rivette fail to disclose or suggest that a graphical collaboration tool, web software browser, and server process all execute on the same computer system. It should be noted that Eintracht at column 7, lines 24-35 discloses that a Notes Clients "browses" documents on the client side, which is different from the process for browsing taking part on the server side.

Thus, Appellants respectfully request that the Honorable Board reverse the Final Rejection of claims 17-22.

**(c) The Rejection of claim 41 over the combination of Eintracht and Rivette fails to establish a prima facie case of obviousness**

The Final Rejection did not provide any suggestion or motivation for combining the teachings of Eintracht and Rivette other than to describe the present claimed invention.

Independent claim 41 would not have been obvious to a person of ordinary skill in view of the combination of Eintracht and Rivette under 35 U.S.C. §103(a). For example, present claim 41 recites a client system for network collaboration including a collaborative content including a base document having a document identifier that identifies a location of content of said base document and at least one collaborative content element having an embedded annotation in said document

identifier.

It is respectfully submitted that Eintracht fails to disclose or suggest a collaboration tool, as this reference discloses separate data structures for the document and the notes. The documents are stored separately from the notes (column 3, lines 15-28). In fact, the documents and the notes are displayed independently "[A]t the client side, the client application layers the annotations over the image (or document) (Eintracht at column 2, lines 53-55).

In response to the Examiner's previous rejection, Applicant submits that in Eintracht, a graphical collaboration tool is not loaded by the client. **The client loads a Note Plug-In application, which is not a collaboration tool. The Note Plug-In application functions to take control of the browser display window and begin displaying the image.** The client can then overlay annotations from the Notes Database onto the underlying image. The Notes Anchor keeps track of where the separately stored Notes will appear when layered over the underlying image after the server has sent a Notes buffer to the client (Col. 14, lines 14-15). Again, Eintracht (in combination with Rivette) fails to disclose or suggest a transmission of collaborative content with rendering instructions embedded in the document identifier.

In contrast with the present claim 41, the client disclosed in Eintracht downloads the Notes Buffer from the Note Plug-In application. Then the layered view can be requested by the client. However, loading a Notes buffer requires large amounts of storage that would preclude devices such as PDAs and smaller (cell phones) from using the application because the size of the Notes buffer would be larger than the capabilities of the handheld devices. Even if a user performed a merge, this merge function would not disclose or suggest the combining into a single URL with embedded notations and rendering instructions (for example, present invention at Figure 5, Listing 2), followed by the rendering of the URL.

For at least the above reasons, Claim 41 patentably distinguishes over the combination of Eintracht and Rivette. In addition, all of the claims dependent from Claim 41 are also believed to be allowable at least because their dependence from an allowable claim (*In re Fine*, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988)). Thus, Appellants respectfully request that the Honorable Board reverse the Final Rejection of claims 41-52.

**(d) The rejection of claim 53 over the combination of Eintracht and Rivette fails to establish a *prima facie* case of obviousness**

The Final Rejection did not provide any suggestion or motivation for combining the teachings of Eintracht and Rivette other than to describe the present claimed invention.

The combination of Eintracht and Rivette fails to disclose or suggest a server system for network collaboration comprising a collaborative content including a base document having a document identifier that identifies a location of a content of the base document and at least one collaborative content element having a first embedded annotation to the document identifier as an encoded representation of the collaborative content, and first rendering instructions.

As previously discussed herein above, the combination of Eintracht and Rivette fails to embed a document identifier with collaborative content and rendering instructions such as that shown in Fig. 5 Listing 2 of the present invention. To reiterate, under no circumstances does the combination of Eintracht and Rivette teach the embedding of the base document and the annotations such that there is a combination leaving, for example, a combination of the URL in Listing 1 and the annotation and rendering instructions in Listing 2 (shown in Figure 5) of the present application and discussed above.

Nor does the combination of Eintracht and Rivette disclose or suggest a server process as claimed, with a second embedded annotation and second rendering instructions, and a third

embedded annotation and third rendering instructions, as the combination of Eintracht and Rivette fails even to embed a first time, let alone a second or third time.

For at least the above reasons, Claim 53 patentably distinguishes over the combination of Eintracht and Rivette. Applicants also respectfully submit that claims are 54-65 also patentable at least for their dependence from claim 53, which is believed to allowable because of the aforementioned reasons.

#### **VIII. Conclusion**

For all of the foregoing reasons, Applicants respectfully request that the Honorable Board of Patent Appeals and Interferences reverse the all rejections of Claims 1-14 and 16-65.



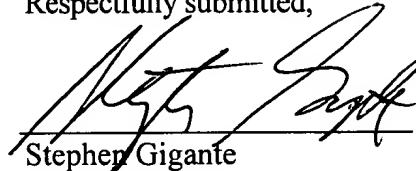
APPENDICES

The following Appendices are attached to and made part of this  
brief:

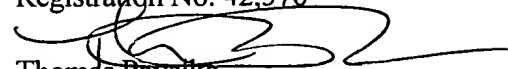
Appendix A	Claims on Appeal
Appendix B	Evidence
Appendix C	Related Proceedings (N/A)

Date: November 3, 2006  
SG  
Attorney Docket No.: TPP31729

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stephen Gigante".

Stephen Gigante  
Registration No. 42,576

A handwritten signature in black ink, appearing to read "Thomas Pavelko".

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APPENDIX A Claims on Appeal

1. A computer-implemented method of network collaboration through embedded annotation and rendering instructions to generate, transmit, and render collaborative content, the method comprising the steps of:

generating by an originator client workstation a collaborative content including a base document having a document identifier that identifies a location of a content; and at least one collaborative content element that comprises at least one annotation therein and rendering instructions therefore so as to annotate said base document by embedding said at least one annotation and instructions therefore as an encoded representation of collaborative content and forwarding the collaborative content to a server for execution;

rendering by a server said collaborative content element to said base document in accordance with said rendering instructions, and providing said collaborative content to said originator client workstation for display.

2. The method as claimed in claim 1 further comprising the step of annotating said collaborative content by adding another collaborative content element.

3. The method as claimed in claim 2 wherein said annotating step comprises presenting annotation options to said client workstation.

4. The method as claimed in claim 2 wherein said annotating step comprises inputting a text element to name said collaborative content element.



5. The method as claimed in claim 2 wherein said annotating step comprises inputting at least one of a symbol, shape and a text input element to generate said at least one of a symbol, shape and a text as said collaborative element.

6. The method as claimed in claim 2 wherein said annotating step comprises providing a visual cue to indicate the state of said collaborative content.

7. The method as claimed in claim 6 wherein said visual cue comprises at least one of a marker, cursor, icon, and marquee box.

8. The method as claimed in claim 59, wherein said transmitting step is initiated by a user selecting a visual element to transmit said collaborative content subsequent to said collaborative content being saved.

9. The method as claimed in claim 1 wherein said originator client workstation includes at least one of a personal computer equipped with internet browser software, a mobile communication device with a graphical or textual display, and a personal digital assistant equipped with a hypertext viewer.

10. The method as claimed in claim 1 wherein said originator client workstation includes a program execution capability comprising:

an interpreted software program;

a compiled software program; and

a software program executed by a virtual machine.

11. The method as claimed in claim 59, wherein said transmitting step is performed using a messaging system.

12 The method as in claim 11, wherein said messaging system includes at least one of:

an electronic mail system;

an electronic news or bulletin-board system; and

a mobile paging system.

13. The method as claimed in claim 59, wherein said transmitting step is performed using a transport mechanism including at least one of:

a wireless protocol;

a synchronous messaging protocol; and

an asynchronous messaging protocol.

14. The method as claimed in claim 1 wherein said network is a peer-to-peer network, and the rendering step is performed on a server portion of said originator client workstation in said peer-to-peer network.

16. The method as claimed in claim 59, wherein the collaborative content transmitted in said transmitting step includes a URL and rendering instructions.

17. A network collaboration tool using embedded annotation and rendering instructions comprising:

a web browser software for displaying a collaborative content in accordance with rendering instructions therefor, said collaborative content including a base document having a document identifier that identifies a location of a content of said base document and at least one collaborative content element having an embedded annotation in said document identifier;

a graphical collaboration tool for generating at least one collaborative content element on the collaborative content displayed in said web browser software and transmitting the at least one collaborative content element and rendering instructions therefore; and

a server process for receiving the at least one generated collaborative content element and rendering instructions therefor, rendering the collaborative content in combination with the received collaborative content element in accordance with the received rendering instructions, and generating a combined collaborative content including the received collaborative content element and embedded annotation in the document identifier thereof for display by said web browser software.

18. The network collaboration tool as claimed in claim 17, wherein said graphical collaboration tool includes a toolbar.

19. The network collaboration tool as claimed in claim 18 wherein said toolbar

includes an add circle tool, an add rectangle tool, an add arrow tool, and add text tool, and an add text highlight tool.

20. The network collaboration tool as claimed in claim 17 wherein said graphical collaboration tool includes a collaborative content element name entry field.

21. The network collaboration tool as claimed in claim 17 wherein said web browser software, said graphical collaboration tool, and said server process execute on the same computer system.

22. The network collaboration tool as claimed in claim 17 wherein said web browser software, said graphical collaboration tool, and said server process each execute on a separate computer system.

23. A system for network collaboration using embedded annotation and rendering instructions comprising:

a processor for receiving and transmitting data; and

a memory coupled to the processor, said memory having stored therein sequences of instructions which, when executed by said processor, cause said processor to generate a collaborative content including a base document having a document identifier that identifies a location of content of said base document, and at least one collaborative content element having an embedded annotation in said document identifier and rendering instructions therefore, to render the collaborative content in accordance with rendering instructions.

24. The system as claimed in claim 23 wherein said memory further comprises sequences of instructions which, when executed by said processor, cause said processor to annotate the collaborative content by adding another collaborative content element.

25. The system as claimed in claim 24 wherein said annotate instructions comprise presenting annotation options to a user at the client workstation.

26. The system as claimed in claim 24 wherein said annotate instructions comprise inputting a text element to name said collaborative content element.

27. The system as claimed in claim 24 wherein said annotate instructions comprise inputting at least one of a symbol, shape and a text input element to generate said at least one of a symbol, shape and text as said collaborative element.

28. The system as claimed in claim 24 wherein said annotate instructions comprise providing a visual cue to indicate the state of said collaborative content.

29. The system as claimed in claim 28 wherein the visual cue comprises at least one of a marker, cursor, icon, and marquee box.

30. The system as claimed in claim 64, wherein said transmit instruction is initiated by a user selecting a visual element to transmit the collaborative content subsequent to said

collaborative content being saved.

31. The system as claimed in claim 23 wherein the client workstation includes at least one of a personal computer equipped with internet browser software, a mobile communication device with a graphical or textual display, and a personal digital assistant equipped with a hypertext viewer.

32. The system as claimed in claim 23 wherein the client workstation includes a program execution capability comprising:

- an interpreted software program;
- a compiled software program; and
- a software program executed by a virtual machine.

33. The system as claimed in claim 64, wherein a transmit instruction is performed using a messaging system.

34. The system as claimed in claim 33 wherein the messaging system includes at least one of:

- an electronic mail system;
- an electronic news or bulletin-board system; and
- a mobile paging system.

35. The system as claimed in claim 64, wherein a transmit instruction is performed

using a transport mechanism including at least one of:

- an internet protocol;
- a wireless protocol;
- a synchronous messaging protocol; and
- an asynchronous messaging protocol.

36. The system as claimed in claim 23, wherein the rendering instructions are performed on a client workstation.

37. The system as claimed in claim 23 wherein the rendering instructions are performed on a server.

38. The system as claimed in claim 64, wherein the collaborative content transmitted includes a URL comprising the embedded annotation and rendering instructions.

39. The system as claimed in claim 23 wherein said sequences of instructions include at least one of a client-side scripting language.

40. The system as claimed in claim 23 wherein said sequences of instructions include at least one of Javascript and dynamic HTML.

41. A client system for network collaboration comprising:  
a collaborative content including a base document having a document identifier that

identifies a location of content of said base document and at least one collaborative content element having an embedded annotation in said document identifier, and rendering instructions therefore; and

a graphical collaboration tool for generating, rendering said collaborative content in accordance with said rendering instructions, and transmitting said collaborative content with said rendering instructions embedded in said document identifier therein, wherein said graphical collaboration tool is downloaded from a server.

42. The client system as claimed in claim 41 wherein said collaborative content is referenceable by a URL.

43. The client system as claimed in claim 41 wherein said graphical collaboration tool includes a client-side scripting language.

44. The client system as claimed in claim 41 wherein said graphical collaboration tool includes at least one of Javascript and dynamic HTML.

45. The client system as claimed in claim 41 wherein said collaborative content includes a URL of the base document and a representation of the collaborative content element.

46. The client system as claimed in claim 41, wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to add a collaborative content element, transmits a representation of the collaborative content element and the URL of



said collaborative content to a server and receives from the server said collaborative content including the added collaborative content element.

47. The client system as claimed in claim 41 wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to modify a collaborative content element, transmits a representation of the collaborative content element and the URL of said collaborative content to a server and receives from the server said collaborative content including the modified collaborative content element.

48. The client system as claimed in claim 41 wherein said graphical collaboration tool includes a toolbar.

49. The client system as claimed in claim 48 wherein the tool bar includes an add circle tool, an add rectangle tool, and add arrow tool, an add text tool, and an add text highlight tool.

50. The client system as claimed in claim 48 wherein the tool bar includes a collaborative content element name entry field.

51. The client system as claimed in claim 46 wherein said collaborative content received from the server includes an HTML page.

52. The client system as claimed in claim 47 wherein said collaborative content

received from the server includes an HTML page.

53. A server system for network collaboration comprising:

a collaborative content including a base document having a document identifier that identifies a location of a content of said base document and at least one collaborative content element having a first embedded annotation to said document identifier as an encoded representation of said collaborative content, and first rendering instructions therefore; and

a server process for responding to a user request wherein the user request includes at least one of a request for said collaborative content, a graphical collaboration tool, said collaborative content including an added collaborative content element having a second embedded annotation to said document identifier as an encoded representation of said added collaborative content, and second rendering instructions therefore, and said collaborative content including a modified collaborative content element having a third embedded annotation to said document identifier as an encoded representation of said modified collaborative content, and third rendering instructions therefore.

54. The server system as claimed in claimed 53 wherein said collaborative content is referenceable by a URL.

55. The server system as claimed in claim 53 wherein said server process is a CGI script.

56. The server system as claimed in claim 53 wherein said collaborative content

includes a URL of the base document and a representation of the collaborative content element.

57. The server system as claimed in claim 53 wherein said server process executes on a client workstation of a user.

58. The server system as claimed in claim 53 wherein said collaborative content transmitted in response to a user request includes an HTML page.

59. The method according to claim 1, further comprising the step of:  
transmitting between said originator client workstation and at least one receiver client workstation a document identifier having said rendering instructions embedded therein and comprising said collaborative content.

60. (Currently Amended) The method as claimed in claim 1 further comprising the step of annotating said collaborative content by adding another collaborative content element by said at least one receiver client workstation.

61. (Currently Amended) The method according to claim 1, wherein the document identifier comprises a Universal Resource Locator (URL).

62. (Currently Amended) The method according to claim 1, wherein the document identifier comprises a Hypertext Markup Language (HTML).

63. (Currently Amended) The method according to claim 1, wherein the document identifier comprises an Extensible Markup Language (XML).

64. (Currently Amended) The system according to claim 23, further adapted for transmitting the collaborative content and rendering instructions therefore between client workstations.

65. (Currently Amended) The system according to claim 64, wherein the client workstations transmit collaborative content and rendering instructions via a server.

## APPENDIX B- EVIDENCE

The 37 C.F.R. §1.132 Declaration signed April 7, 2005 by two experts was not considered persuasive to overcome rejection of any of the claims under 35 U.S.C. 102(e) in view of Eintracht (U.S. 6,687,878), as noted in the Office Action mailed July 28, 2005. The Declaration addresses several points about Eintracht and provides an explanation of the differences between the Eintracht reference and the claimed invention. The Declaration does reference the specification at points and provide the two experts' view on the claimed invention and the reference.

The Examiner still appears to misinterpret what the term "embedding" means in reference to the claimed invention versus the separate data streaming and layering of "Eintracht", which has also been discussed in detail in the Argument Section of this brief. Although the Examiner has since changed the rejection to 35 U.S.C. §103(a) in view of the combination of Eintracht and Rivette after the initial rejection, the Applicants have traversed rejections under 35 U.S.C. §103(a), arguing that limitations of the claimed invention are not the same as the cited teachings of the Eintracht reference, with or without Rivette. In order to explain that certain of the limitations recited by the claims as are not the same as the features taught by the Eintracht reference and cited by the Examiner as the same, a declaration of a two experts in the design, implementation and use systems and processes for network collaboration through embedded annotation and rendering was included with the Amendment After Final Rejection that explains these differences where they exist, in the opinion of the expert, on a claim-by-claim, limitation-by-limitation basis.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Stephen JOHNSON, et al.

Serial No.: 09/804,074      Group Art Unit: 2154  
Filed: March 13, 2001      Examiner: Mohammad A. Siddiqi

For: A SYSTEM AND PROCESS FOR NETWORK COLLABORATION  
THROUGH  
EMBEDDED ANNOTATION AND RENDERING INSTRUCTIONS

**DECLARATION UNDER 37 C.F.R. 1.132**

I, TED FRIEL, am over 21 years of age, and if called to testify would be competent to testify as to the following matters:

- (1) I have been a computer consultant for 35 years, attended college at the Dartmouth and Amos Tuck and received a Bachelor of Business Administration in year 1965 attended graduate school at the State University of New York at Buffalo and received a PhD in year 1969.
- (2) My experience relevant to this case includes designing and managing the development of document management systems incorporating significant collaboration components.
- (3) I have provided a Declaration as an expert witness on behalf of the Assignee of the present patent application one other time and in a different patent prosecution.
- (4) I have been employed for 5 years as a Systems Designer at ePlus, the Assignee of U.S. Patent Application No. 09/804,074 entitled "A System and Process for Network Collaboration through Embedded Annotation and Rendering Instructions". I am being compensated for my time in preparing this Opinion by the Assignee; however I have no financial interest in the outcome of the prosecution of U.S. Patent Application No. 09/804,074.

- (5) I am familiar with the prosecution history of Application No. 09/804,074: I have received copies of and read:
- a) the patent application filed on March 3, 2001 and published as Pub. No. US 2003/0023679 on January 30, 2003;
  - b) the first Office action mailed on September 21, 2004 and the references cited therein;
  - c) the Applicants' response to the first Office Action filed on October 21, 2004;
  - d) the Final Rejection mailed on February 10, 2005 and the references cited therein; and
  - e) the Applicants' response to the Final Rejection filed concurrent herewith.
- (6) I am fully familiar with and deal with the following technologies on a daily basis:
- a) document management systems comprising a significant collaboration component;
  - b) databases for managing the life history of documents, including annotations resulting from collaboration; and
  - c) system architectures for networked document management system in which collaboration is conducted by a plurality of users over the network, i.e., system architectures for supporting geographically and organizationally distributed communities of users (culturally different communities of business users).

I, AL BLANCHETTE, am over 21 years of age, and if called to testify would be competent to testify as to the following matters:

- (1) I have been a computer software engineer for 25 years, attended college at the University of Massachusetts and received a Bachelor of Science degree in

Physics in 1980 and attended graduate school at the University of Massachusetts and received a Master of Science degree in Computer and Electrical Engineering in 1989.

- (2) My experience relevant to this case includes designing and managing the development of document management systems incorporating significant collaboration components.
- (3) I have been employed for 3 years as a Senior Software Architect at ePlus, the Assignee of U.S. Patent Application No. 09/804,074 entitled "**A System And Process For Network Collaboration Through Embedded Annotation And Rendering Instructions**". I am being compensated for my time in preparing this Opinion by the Assignee; however I have no financial interest in the outcome of the prosecution of U.S. Patent Application No. 09/804,074.
- (4) I am familiar with the prosecution history of Application No. 09/804,074: I have received copies of and read:
  - f) the patent application filed on March 3, 2001 and published as Pub. No. US 2003/0023679 on January 30, 2003;
  - g) the first Office action mailed on September 21, 2004 and the references cited therein;
  - h) the Applicants' response to the first Office Action filed on October 21, 2004;
  - i) the Final Rejection mailed on February 10, 2005 and the references cited therein; and
  - j) the Applicants' response to the Final Rejection filed concurrent herewith.
- (5) I am fully familiar with and deal with the following technologies on a daily basis:
  - a) document management systems comprising a significant collaboration component;
  - b) databases for managing the life history of documents, including



- annotations resulting from collaboration; and
- c) system architectures for networked document management system in which collaboration is conducted by a plurality of users over the network, i.e., system architectures for supporting geographically and organizationally distributed communities of users (culturally different communities of business users).

### **DIFFERENCES BETWEEN THE TEACHING OF EINTRACHT AND THE PRESENT DISCLOSED AND CLAIMED INVENTION**

#### **A. Summary**

The present disclosed and claimed invention is different from the teachings of Eintracht:

- the present claimed invention recites a scripting language within a browser to provide collaboration functions for generation of user-specified collaborative content elements that are transmitted to a server process for rendering of the collaborative content elements (e.g., note) within a document and subsequent transmission of the rendering back to the client for presentation to the user by a web browser, which is not the same as the teaching of Eintracht of a client-side software application (e.g., a web browser plug-in) which provides for separate receipt of a document and associated collaborative content elements from a server by the browser plug-in for subsequent rendering within the plug-in at the client.
- the present claimed invention recites a server-level process that combines a URL for a base document with associated collaborative content elements into a collaborative content and transmits this combination as a collaborative content to the user at a client, which is not the same as the teaching of Eintracht of a server-level process that maintains documents in a separate database from a notes database, transmits both to a client as separately in separate data streams and a client-side software application that layers the separately received document and notes using a Notes

Anchor (X,Y position of the notes in the document) for presentation by the plug-in to a user at the client;

- the present claimed invention recites client-to-client collaboration (claims 1 and 23), i.e., enables user directed collaboration with other users since the present claimed invention recites a client sending collaborative content having embedded annotations directly to other selected users (other clients), and by sending a URL link (claims 16, 38, 42, and 45) via email (claims 11, 12, 33 and 34) that contains information about both the document being collaborated upon and collaborative content elements having embedded annotations whereas Eintracht teaches a server directs collaboration such that upon the server receiving a note update from a client, the server prompts related clients to poll the server to download the note updates and/or the server transmits back to the original client any new notes that other clients may have posted since a last synchronization was performed.

Consequently, even though Eintracht and the present claimed invention are both related to a system and method for collaborative communication, the present invention recites a fundamentally different invention than do the teachings of Eintracht. Eintracht teaches only server-based management and downloading of documents and annotations as separate data streams to clients who then use a web browser plug-in to render by layering the documents and annotations for presentation to a user. The present claimed invention recites a server process that combines documents and collaborative content elements into a collaborative content which is then downloaded to clients, clients select the elements they wish to have rendered and transmit a rendering request (containing a collaborative content having embedded annotations and rendering instructions) back to the server process which then renders the collaborative content according to the rendering instructions and transmits back the rendered collaborative content for display by a web browser at the client. Finally, the present claimed invention differs from the server-based management taught by Eintracht since the present invention recites client-to-client

transmitting of collaborative content (claims 1 and 23). It should also be noted that the present invention does not recite client-side application software (client process) to render collaborative content comprising a document and its associated annotations even though the present invention recites that a server process that does the rendering and a client web browser that displays this rendering as received from the server process can execute on the same computer.

Thus the teachings of Eintracht are not even equivalent to those of the present claimed invention for at least the reasons that Eintracht accomplishes collaboration functions in a different way than the present claimed invention, transfers base documents and associated annotations between a server process and client processes in a different way than the present claimed invention, and does not teach or even suggest the function of client-to-client collaboration as recited by the present claimed invention of claims 1 and 23.

#### **B. Support**

The following sections support these conclusions regarding the differences between the cited teachings of Eintracht and the disclosed and claimed present invention.

#### **The Basic Technological Structures Differ**

Eintracht requires a client software application (e.g., a web browser plug-in) that resides on the client side, and manages the client-side tasks (col. 2, lines 37-40).

The present invention does not disclose a client software application –

“[0044] The present invention is a system and process for network collaboration using embedded annotations and rendering instructions to enable collaborators to generate, share or transmit, and render collaborative content over the internet. Collaborators are able to view, generate, and render the collaborative content **without installing any application software on their computer systems other than a web browser**. Recipient collaborators may view the content by installing only a web or Internet browser on their computer system. Collaborators may share the collaborative content by transmitting a message including a URL, which not only contains the identity of the base document but also includes an encoded representation of the collaborative content added to the base document by a collaborator. The URL is self-contained, and can be distributed using synchronous or asynchronous messaging systems. “

Consequently, sites that do not allow plug-ins for security reasons, or users who have devices whose memory capacities will not support plug-ins, are not able to use the teachings of Eintracht, but are able to use the present invention.

### **Annotations are Different, and are Generated differently**

Eintracht uses a client software application (e.g., a web browser plug-in) to generate a **textual** note –

“On the client side, the notes client functions to display the document that the user wishes to annotate and provides the tools necessary to permit the user to create, edit, delete, retrieve and store notes.” (Abstract)

“The plug-in contains the user interface for navigating within the document and for handling the notes.” (col. 2, lines 39-40)

On the client side the present invention purposefully does not use a software application, (e.g., a web browser plug-in) and instead discloses and claims a scripting language. It emphasizes graphical annotations, which can include textual notes but are not just textual notes. It discloses and claims a graphical annotation tool (not a plug-in) written in JavaScript that operates under web browser control to enable the user to draw and label annotations:

[0018] It is therefore an object of the present invention to allow collaboration between networked computer users **without requiring** a dedicated collaboration application on the user's computer system.

[0063] In accordance with a preferred embodiment of the present invention, FIG. 4 is a schematic of an implementation of the present invention based on the server model first introduced in FIG. 2 including an originator 80 using a messaging system 81 to transmit collaborative content to a receiver 82. Both originator 80 and receiver 82 client workstations are represented by personal computers running a multimedia Internet browser software supporting a **client-side scripting language**, such as JScript or Javascript, and Dynamic HTML elements. The role of the client workstations is to allow the interactive creation of collaborative content, and presentation of the content as delivered by a server process 84. In the preferred embodiment, **the client-side scripting language is**

used to improve the user interaction with the workstation 80, 82 and give visual cues to aid in creating a collaborative element, as described below. It is the responsibility of the server process 84 to receive an encoded representation of the collaborative content (as a URL) and render the content, e.g., in a common gateway interface (CGI) process, for presentation on one of the client workstations 80, 82. The messaging system (51 of FIG. 2) of the preferred embodiment is an electronic mail (email) system 81, e.g., simple mail transport protocol (SMTP). The transport mechanism (54 of FIG. 2) is hypertext transport protocol (HTTP) over transmission control protocol/internet protocol (TCP/IP) 83.”

### **Annotations and Documents are Integrated – i.e., “Rendered” - Differently**

Eintracht teaches a client software application to render the documents and their annotations as layered and NOT integrated. Eintracht teaches storing the documents and notes in separate databases at a server, retrieves them separately, and transmits them in separate data streams to the client software application, where they are rendered, i.e., layered for display.

“In accordance with the invention, the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the **client application** layers the annotations over the image (or document) in accordance with the coordinates of each.” (col. 2, lines 50-55)

There is also provided in accordance with the present invention method of annotating documents, the method comprising the steps of getting a first request comprising a Universal Resource Locator (URL) associated with a document to be viewed and annotated and transmitting the first request from a client to a server, sending a first response from the server in response to the first request, the first response comprising the document type of and a representative of the requested document, getting a second request comprising a document note URL corresponding to the notes associated with the document and sending the second request from the client to the server, sending a second response from the server in response to the second request, the second response comprising one or more notes associated with the document, displaying the representation of the document and the associated one or more notes locally on the client such that both are viewable simultaneously, permitting the user to perform annotation functions on the client so as to generate a third request

comprising one or more note events related to the document that are transmitted from the client to the server and sending a third response from the server to the client in response to the third request, the third response comprising an updated list of notes associated with the document, the list of notes incorporating any note events previously received from other clients (col. 4, lines 14-38).

The Notes Server generates **two independent HTTP streams**: the first stream is for the displayed image and the second stream is for the annotations (col. 9, lines 56-60)."

The present invention discloses and claims a **server process** to "render" the collaborative documents and related annotations.

"[0028] ...The **server** process receives the generated collaborative content elements, renders the collaborative content in combination with the collaborative content elements, and generates a combined collaborative content including collaborative content elements for display by the web browser."

The present invention discloses and claims combining a document with the annotations thereto at a server whereas Eintracht teaches transmitting the document and each annotation in a separated data stream from the server to the client (Eintracht teaches that *"the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document"* (col. 2, lines 50-53)).

"[0023] Yet another object of the present invention is to provide for the transmission of the collaborative content and the subject drawing by exchanging the URL of the content, and rendering instructions **as part of** that URL.

[0024]...The message sent between collaborators is a URL, which not only contains the identity of the base document **but also includes** an encoded representation of the collaborative content added to the base document by a collaborator. The URL is self-contained, and can be distributed using synchronous or asynchronous messaging systems.

[0072] FIG. 5 shows a sample of the encoded collaborative content as produced by the preferred embodiment (Listing 1 and 2) and an alternate

XML implementation (Listing 3). The complete encoding consists of URL part one (Listing 1) followed immediately by URL part two (Listing 2). URL part one contains the base document or content identifier, its location on a document repository, e.g., persistent base document storage 55, and detailed viewing information. The detailed viewing information specifies the zoom level and position of the view on the particular drawing. Part one of the URL refers to the base document, and is not altered by the collaboration process.

[0073] URL part two contains the encoded annotations. In this example, the content includes three collaborative elements: a red circle, a red arrow, and a text area containing the text: "this is a collaborative element". The complete URL as specified by parts one and two is:

[0074]  
[http://localhost/dpr/ds.dpv/00016J/1/123?dpv=bt7dc0dm1dn1do1e0h5i68-00j4400k25610n2441o25p1r0s33st0t0tt0w7x896xm0xt7y640ym0yt5&DPDB\\_IDNT=/GIBB-S/00016J/1&DPDB\\_SH=04131&\\_RCR=circle.vertline.240.vertline.2542.vertline.-2565.vertline.3248.vertline.1&\\_RAR=arrow.vertline.3544.vertline.312.vertline.2982.vertline.2701.vertline.1&\\_RTX=this%20is%20a%20collaborative%20element.vertline.3544.vertline.3058.vertline.5229787.vertline.13176.vertline.1?1,448](http://localhost/dpr/ds.dpv/00016J/1/123?dpv=bt7dc0dm1dn1do1e0h5i68-00j4400k25610n2441o25p1r0s33st0t0tt0w7x896xm0xt7y640ym0yt5&DPDB_IDNT=/GIBB-S/00016J/1&DPDB_SH=04131&_RCR=circle.vertline.240.vertline.2542.vertline.-2565.vertline.3248.vertline.1&_RAR=arrow.vertline.3544.vertline.312.vertline.2982.vertline.2701.vertline.1&_RTX=this%20is%20a%20collaborative%20element.vertline.3544.vertline.3058.vertline.5229787.vertline.13176.vertline.1?1,448)

[0075] and is sent via email (the preferred embodiment messaging system 51) to the recipient client workstation, where it is rendered as HTML (the preferred embodiment markup language) by the server process 53."

## The Collaboration Process is Controlled Differently

The present invention discloses and claims (claim 1 and 23) a user determines to who the collaborative communication is to be sent:

“[0062] Once the collaborative content is received by the receiver 52 at step 74, the receiver 52 sends the collaborative content to the server process 53 where it is rendered at step 75 by the server 53 to a markup language for rendering and display at step 76 by receiver 52 using display 22. The user at receiver 52 then decides at step 77 whether to end the process and proceed to step 78, or to become an originator 50 at step 79 and create collaborative content at step 71 and **send it to the prior originator 50 or another collaborating user.** At step 79, the receiver 52 takes on the role of originator 50 and has the ability to create a collaborative element. The process continues until the recipient of the content decides not to send further collaborative content and the flow proceeds to step 78.

[0071] Each time the server process 53 completes the rendering task, the HTML page is returned to the originator 50 client workstation, and displayed on the display 22, and even more importantly, the encoded collaborative content is stored in the URL of the HTML page or content. When the user at originator 50 is finished constructing the collaborative elements, **he may send the encoded content (in this case, the URL) to a receiver 52 client workstation using the messaging system 51 by pressing the "send" button 45C.** The send button 45C transmits the URL including the URL of the content and the encoded collaborative elements to another user. It is to be understood that even though an email embodiment has been described, the present invention is usable with other forms of message or content transmission, e.g., file transfer protocol, telnet, chat, or instant messaging.”

Whereas Eintracht teaches all annotations are sent by clients to the server, and the server triggers the users to poll the server to download new notes.

“Synchronization – Events are exchanged between the server and the clients. Notes Clients forward to the Notes Server requests to view, modify, create or delete notes. In response, the Notes Server Updates the clients with an up to date note list per document. This updating activity is termed Note Synchronization. The synchronization process is performed



asynchronously and is always initiated by the Notes Client in response to the user, i.e., it is user driven (col. 9, lines 16-23).

Alternatively, the synchronization process can be initiated by the Notes Client in a periodic manner, i.e., polling, or by the Notes Server when the exchange protocol in use allows for it. In the former case, the client would continuously poll the server. Utilizing Java in the server, rather than HTTP, permits the server to trigger the client and update the client display, if permitted to, since it is not practical for the server to poll clients. The server pushes new notes to selected clients by triggering them to pull new notes from the server. This serves to simulate a user pressing a synchronization button. This service can be provided for those clients that request it (col. 9, lines 24-36)."

### **The Present Invention is Designed to be Used Differently**

Eintracht teaches a collaborative system and method for use in typical workplaces where plug-ins are not a security or memory space issue, and where users have workstations connected to LANs where transmission speeds and bandwidths are not critical issues.

The present invention does not disclose or recite a client-side software application (e.g., a web browser plug-in) as does Eintracht. This allows the present claimed invention to be used by people in typical workplace environments as well as by people in situations (e.g., in the field) where they are limited to using devices that do not easily or practically support a sizable plug-in (e.g., hand-helds, pdas, etc.), or where transmission speed and bandwidth limitations are practical issues.

"[0027] ...Advantageously, no dedicated software is needed for the client workstation and the client workstation may be a personal computer equipped with Internet browser software, a mobile communication device with a graphical or textual display, and a personal digital assistant equipped with a hypertext viewer. Further advantageously, the collaborative content transmitted to a client workstation need only include a URL and rendering instructions to enable a user to view the collaborative content.

[0077] The advantage of the present invention is that the client workstations do not need any software installed other than an internet

browser and an embedded scripting language. The only application software that needs to be installed is on server process 53. This architecture makes the collaboration process available to any device with internet browser and server connectivity. This "zero footprint" client makes the solution very attractive for information technology (IT) departments, security personnel, support personnel, and mobile device users."

### C. Claim-by-Claim Analysis of Differences

#### Claims 1 and 23

The Office Action alleges

*"Eintracht discloses a computer-implemented method of network collaboration through embedded annotation and rendering instructions to generate, transmit, and render collaborative content, the method comprising the steps (see abstract, col. 2, lines 8-67, col. 3, lines 1-67) of:*  
    *generating a collaborative content including a base document and at least one collaborative content element (col. 2, lines 40-46);*  
    *rendering said collaborative content (col. 2, lines 8-55); and*  
    *transmitting said collaborative content between client workstations. (lines 8-67)."*

I disagree with the Examiner's allegations that the recited limitations of present claims 1 and 23 are the same as the cited teachings of Eintracht at col. 7 lines 55-57, Eintracht

*"An annotation or note is a portion of text or a graphical drawing that is associated with a specific location in a document. ... The location associated with a note in the document is called a Note Anchor and is kept separate from the annotation data itself. Once a note is created, its anchor point can be changed by the user. The note anchor is expressed in terms of (X,Y) coordinates in the annotated page of a document."*

At col. 2, lines 40-46 Eintracht teaches a synchronization button which *transmits annotations generated by the user from the client to the server* which is not the same as the limitation recited by claims 1 and 23

*"generating a collaborative content including a base document and at least one collaborative content element"*

since only annotations, i.e., only collaborative content elements and not a base document and at least one collaborative content element, are taught by Eintracht as being generated. Nowhere does Eintracht either teach or suggest generating a collaborative content including a base document and at least one collaborative content element as recited by the present invention of claims 1 and 23. At most Eintracht teaches generating a note as a collaborative content element and a note is not the same as a base document and at least one collaborative content element, as recited by claims 1 and 23.

At col. 2, lines 11-55 Eintracht teaches transmitting notes and documents in separate data streams between the client and a notes server and that the client layers annotations over a base document

“...The documents and associated annotations are treated independently from each other. Separate data structures are created for the documents and for the associated annotations thus permitting their independent management.

...

The notes information is transmitted between client and server applications via TCP/IP protocols over communications means. ... On the client side a client software application functions to display the document that the user wishes to annotate and provides the tools necessary to permit the user to create, edit, retrieve and store notes.

...

At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each.”

which layering of annotations over a document image is not the same as

*“generating a collaborative content including a base document and at least one collaborative content element”*

recited by the present invention of claims 1 and 23.

Further, nowhere does Eintracht teaches or suggests transmitting a collaborative content including a base document and at least one collaborative content element. The recited locations of col. 2, lines 8-67 teach *inter alia* transmitting notes and documents separately

“In accordance with the invention, the annotations are transmitted from the server *independent* of the data transmitted that is related to the viewed document (col. 2, lines 50-53). At the client side, the client application layers the annotations over the image (or document in accordance with the coordinates of each (col.2, lines 53-55).”

The recited limitation of claims 1 and 23

“*transmitting said collaborative content between client workstations (claim 1)*”  
and  
“*transmit the collaborative content between client workstations (claim 23)*”

is not the same as the teaching of Eintracht of the independent transmission from the server of annotations and data related to the viewed document and, what’s more, Eintracht nowhere teaches or suggests transmitting collaborative content between client workstations.

#### **Claims 2 and 24**

The Office Action alleges

“*Eintracht discloses further comprising the steps of annotating said collaborative content by adding (col. 2, lines 44-46) another collaborative content element (col. 2, lines 34-67).*”

I disagree with the Examiner’s allegations that the recited limitations of present claims 2 and 24 are the same as the cited teachings of Eintracht.

At least at col. 2, lines 44-46, Eintracht teaches that the notes server, in response to a client submitting a new note to the server, acknowledges the transmission and sends to the user any other new notes created by other clients that are related to the document the user is viewing – these notes being sent separately from the document to which they relate, as discussed above for claims 1 and 23.

At col. 2, lines 34-67, Eintracht teaches that multiple users can add multiple notes to a document.

Present claim 2, dependent from present independent claim 1, recites adding another collaborative content element to the generated collaborative content which content includes said base document and at least one collaborative content element, as

recited by claim 1. As argued above for present claims 1 and 23, Eintracht does not teach or suggest collaborative content as including a base document and at least one collaborative content element. Therefore, Eintracht's teaching of transmitting annotations (collaborative content elements) independent of the associated document (base document) is not the same as the recited limitation of claims 2 and 24 of adding another collaborative content element to said collaborative content recited by claims 1 and 23 because Eintracht nowhere teaches or suggests a collaborative content as recited by claims 1 and 23.

### Claims 3 and 25

The Office Action alleges

*" Eintracht discloses wherein said annotating step comprises presenting annotation options to said client workstation (col. 2, lines 34-67)."*

I disagree with the Examiner's allegation that the recited limitation of present claims 3 and 25 is the same as the cited teaching of Eintracht..

At col. 2, lines 34-37, Eintracht teaches enabling the user to create, edit, retrieve and store one or more **textual** notes. This is not presenting annotation options; it is presenting the user with one type of annotation option – i.e., a text note – that can be repeated. This teaching of Eintracht of multiple annotations is not the same as the limitation of annotation options, i.e., multiple options for annotating a document, recited by present claims 3 and 25.

It is noted that claims are interpreted in light of the specification and to support the argument that present claims 3 and 25 are reciting multiple annotation options and not multiple annotations, the following paragraphs of the specification are cited in which the user is presented with **multiple annotation** options for creating an annotation. In these sections, in addition to a note option, the multiple annotation options include a circle, a rectangle, an arrow, and a highlight tool. In addition, the user has several options for managing the annotation that include controls for zooming, emailing, printing and scrolling.

“[0028] In accordance with an apparatus aspect of the present invention, a network collaboration tool using embedded annotation and rendering instructions is disclosed. The tool includes a web browser software for displaying collaborative content, a graphical collaboration tool for generating a collaborative content element on the collaborative content and for transmitting the collaborative content element, and a server process. The server process receives the generated collaborative content elements, renders the collaborative content in combination with the collaborative content elements, and generates a combined collaborative content including collaborative content elements for display by the web browser. The tool includes a toolbar having an add **circle** tool, an add **rectangle** tool, an add **arrow** tool, an add **text** tool, and an add text **highlight** tool.

[0064] FIG. 6 shows the originator 50 client workstation screen display 22 and the environment used to generate collaborative elements within a browser window. The browser window includes a document viewer, e.g., DocQuest available from Digital Paper, Inc., for viewing large format drawings over the Internet. The document viewer includes a border 45 having controls for manipulating the user's view of a document or content, e.g., a **zoom** control 45A for controlling the zoom level at which the user view's the content, a **print** control 45B for printing a paper copy of the content, an **email** control 45C for sending the content via email to a recipient, and a **scroll** right control 45D for scrolling the user's content view toward the right-hand portion of the content. The collaboration tools, buttons, and fields make up a graphical collaboration tool.”

#### Claims 4 and 26

The Office Action alleges

*“ Eintracht discloses wherein said annotating step comprises inputting a text element to name said collaborative content element (col. 15, lines 10-16)”*

I disagree with the Examiner's allegation that the recited limitation of present claims 4 and 26 is the same as the cited teaching of Eintracht.

At col. 15, lines 10-16 Eintracht teaches selecting a place on the screen to place a note, and then entering the text of the note which is not the same as the recited limitation of claims 4 and 26 of inputting a text element **to name** said collaborative content element. Further, Eintracht nowhere teaches or suggests inputting a text element to name said collaborative content element.

### **Claims 6 and 28**

The Office Action alleges

*“Eintracht discloses wherein said annotating steps comprises providing a visual cue to indicate the state of said collaborative content composition step (col. 2, lines 65-67)”*

I disagree with the Examiner’s allegation that the recited limitation of present claims 6 and 28 is the same as the cited teaching of Eintracht.

At col. 2, lines 62-67, Eintracht teaches that new or updated notes related to a given document are synchronized with other document users by means of the server sending a notification to a client software application that updates are available. The notification can be in the form of “visual indications, audio and/or e-mail” (col. 2, line 67). This notification of the availability of other notes for a given document is not the same as a visual cue to indicate the state of the collaborative content being composed at the client and as recited by present invention of claims 6 and 28.

### **Claims 8 and 30**

The Office Action alleges

*“Eintracht discloses wherein said transmitting step is initiated by a user selecting a visual element to transmit said collaborative content (col. 2, lines 47-67, col. 3, lines 1-4)”*

I disagree with the Examiner’s allegation that the recited limitation of present claims 8 and 30 is the same as the cited teachings of Eintracht.

At col. 2, lines 47-67, and col. 3, lines 1-4, Eintracht teaches: how a user can use a “synchronization button ... (that) transmits the annotations generated by the user from the client to the server ...” col. 2, lines 41-43; how the server notifies other users that an update is available; and how users can elect to receive the update. Eintracht teaches that “the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document” (col. 2, lines 50-53).

As argued many times above, nowhere does Eintracht teach that a “collaborative content” includes **both** a base document and a collaborative content element **as said collaborative content and therefore the cited teaching of Eintracht is are not the same as the claimed limitation of Claims 8 and 30**

*“said transmitting step is initiated by a user selecting a visual element to transmit said collaborative content”.*

### **Claims 15 and 37**

The Office Action alleges

*“Eintracht discloses wherein said rendering step is performed on a server (col. 8, lines 34-39; col. 2, lines 56-67)”*

I disagree with the Examiner’s allegation that the recited limitation of claims 15 and 37 is the same as the cited teachings of Eintracht.

At col. 8, lines 34-39 Eintracht teaches that the notes server manages the documents and the notes **separately**, that the documents can reside on a remote file server

At col. 2, lines 56-67 Eintracht teaches the use of the notes server to transmit updates of new notes from multiple users to other users who are using the same document. Eintracht teaches the server is used to alert users that new updates are available. Further, Eintracht teaches that the notes are stored and transmitted separately from the document at col. 6, lines 39-43, col. 14, lines 42-47; and are integrated – or “rendered” – by the plug-in on the **client-side** at col. 2, lines 39-40.

In the present invention of claims 15 and 37, the collaborative content (i.e., the base document and its related collaborative content element) is rendered on the server which is not the same as the client-side rendering of the collaborative content taught by Eintracht

### **Claims 16 and 38**

The Office Action alleges

*“Eintracht discloses wherein the collaborative content transmitted in said*



*transmitting step includes a URL and rendering instructions (col. 4, lines 53-58)."*

I disagree with the Examiner's allegation that the recited limitation of present claim 16 and 38 are the same as the cited teachings of Eintracht.

At the cited location of col. 4, lines 53-58, Eintracht only teaches a brief description of the drawings.

As argued above, repeatedly, Eintracht nowhere teaches or suggests a collaborative content including a base document and a collaborative content element and therefore cannot teach that

*"the collaborative content transmitted in said transmitting step includes a URL and rendering instructions".*

The recited limitation of claims 16 and 38 that the collaborative content transmitted in said transmitting step includes a URL and rendering instructions is not the same as FIGs. 1A, 1B, 1C of Eintracht.

#### **Claim 17**

The Office Action alleges

*"Eintracht discloses a network collaboration tool using embedded annotation and rendering instructions comprising:*

*a web browser software for displaying collaborative content (col. 2, lines 9-67, col. 7, lines 24-44);*

*a graphical collaboration tool for generating at least one collaborative content element on the collaborative content displayed in said web browser software and transmitting the at least one collaborative content element (fig 2-3, col. 2, lines 9-67, col. 7, lines 24-44);*

*and a server process for receiving at least one generated collaborative content elements, rendering the collaborative content in combination with the collaborative content elements, and generating a combined collaborative content including collaborative content elements for display by said web browser software (fig 2-3, col. 2, lines 9-67, col. 7, lines 24-44)."*

I disagree with the Examiner's allegations that the recited limitations of present claim 17 are the same as the cited teachings of Eintracht.

At col. 2, lines 9-67, Eintracht teaches server-side and client-side software, where the client-side software is an application that functions to display the document that the user wishes to annotate and provides the tools necessary to permit the user to create, edit, retrieve and store notes. Note that the client software application can be implemented as a web browser plug-in module. The plug-in contains the user interface for navigating within the document and for handling the notes. Nowhere does Eintracht teach or suggest a plug-in as a "*network collaboration tool using embedded annotation and rendering instructions*" because Eintracht teaches at col. 2, lines 50 et seq.

"In accordance with the invention, the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each."

As argued repeatedly above, Eintracht nowhere teaches or suggests that annotations are *embedded in transmitted messages* or that rendering instructions are *embedded in transmitted messages*.

At col. 7, lines 24-44 Eintracht teaches the use of a plug-in on the client side to display collaborative content. The present invention of claim 17 does recite a plug-in for displaying collaborative content. A plug-in as taught by Eintracht is not the same as web browser software for displaying collaborative content recited by claim 17 because a plug-in is additional software that plugs into a web browser and is not the web browser software itself.

At col. 2, lines 16-18 Eintracht teaches the use of server side and client side software. However, Eintracht nowhere teaches or suggests a graphic (i.e., drawing) collaboration tool for generating at least one collaborative content element (i.e., annotation) as recited by the present invention. Therefore, no teaching of Eintracht, either at the cited locations or anywhere else in the Eintracht reference is the same as the recited limitation of present claim 17 of

*“a graphical collaboration tool for generating at least one collaborative content element on the collaborative content displayed I said web browser software and transmitting the at least one collaborative content element.”*

At col. 2, lines 42-46 Eintracht teaches the use of a synchronization button to transmit separate notes to a notes server. As noted above, Eintracht also teaches that the client side, not the server side, layers the document and the associated notes in a display. Consequently, Eintracht’s teaching of a client side application that layers the document and associated annotations on a display is not the same as

*“a server process for rendering the collaborative content and elements, and generating a combined collaborative content”*

as recited by present claim 17.

#### **Claim 21**

The Office Action alleges

*“Eintracht discloses wherein said web browser software, said graphical collaboration tool, and said server process execute on the same computer system (col. 7, lines 24-35).”*

I disagree with the Examiner’s allegation that the recited limitation of present claim 21 is the same as the cited teaching of Eintracht.

At col. 7, lines 24-35, Eintracht teaches FIG. 3, which is a block diagram that clearly depicts notes-client workstations that contain a browser and a plug-in. These workstations utilize the internet to reach a web server that contains a note agent. The web server screens external requests, and provides authorized clients access to a notes server and a notes database. The client-side applications and systems are clearly not resident on the same computer system as the server side applications and systems. Eintracht also teaches at col. 7, lines 34-35 that the “notes client is the tool used for browsing the documents located on the server side.” At col. 10, lines 27-29 Eintracht teaches that only the notes sever and the web server can reside on the same computer.

Eintracht nowhere teaches or suggests that the client-side plug-in and the web browser and the web server and the notes server and the notes database all reside on the

same computer/system. Here, one ordinarily skilled in the art of collaboration systems would realize that 'same' has its ordinary meaning of executing on the selfsame computer system indicating that the computer systems are one and are not two or more computer systems (Merriam -Webster's Collegiate Dictionary, 10<sup>th</sup> Ed, 2000). Consequently, neither the cited teachings of Eintracht nor any other teaching of Eintracht is the same as the recited invention of claim 21

*"said web browser software, said graphical collaboration tool, and said server process execute on the same computer system."*

### **Claim 22**

The Office Action alleges

*"Eintracht discloses wherein said web browser software, said graphical collaboration tool, and said server process each execute on a separate computer system (fig. 2-3,col. 7, lines 24 -51)."*

I disagree with the Examiner's allegation that the recited limitations of present claim 22 are the same as the cited teachings of Eintracht.

In FIG. 3, Eintracht teaches that the notes client comprises application software, e.g., a web browser and plug-in, and the application software is used to create the textual note that is attached to the document. Nowhere does Eintracht teach or suggest that each of these components execute on a separate computer.

In FIG. 2, Eintracht teaches that the annotation tool creates a textual note. Nowhere does Eintracht teach or suggest that the annotation tool is a graphical (i.e., a "drawing") collaboration tool.

Therefore, the cited teachings of Eintracht are not the same as the claimed invention recited by claim 22, namely

*"wherein said web browser software, said graphical collaboration tool, and said server process each execute on a separate computer system."*

### **Claim 39**

The Office Action alleges

*“Eintracht discloses wherein said sequences of instructions include at least one of a client-side scripting language (page description language, col. 6, lines 31-54).”*

I disagree with the Examiner’s allegation that the recited limitation of present claim 39 is the same as the cited teaching of Eintracht.

At col. 6, lines 31-54, Eintracht teaches only that different types of documents can be used, and that the documents can be expressed in a **page description language** such as Postscript or Adobe PDF. However, **page description languages are not scripting languages** as disclosed and claimed by the present invention. The common meaning of these terms and the source for this common meaning is

**Page Description Language** - Abbreviated as PDL, a language for describing the layout and contents of a printed/displayed page. The best-known PDLs are Adobe PostScript and Hewlett-Packard PCL (Printer Control Language), both of which are used to control laser printers.  
Source - <http://www.webopedia.com>

**Scripting Language** – A high-level programming language that is interpreted by another program at runtime rather than compiled by the computer’s processor as other programming languages (such as C and C++) are. Scripting languages, which can be embedded within HTML, commonly are used to add functionality to a Web page, such as different menu styles or graphic displays or to serve dynamic advertisements. These types of languages are client-side scripting languages, affecting the data that the end user sees in a browser window. Other scripting languages are server-side scripting languages that manipulate the data, usually in a database, on the server. Scripting languages came about largely because of the development of the Internet as a communications tool. JavaScript, ASP, JSP, PHP, Perl, Tcl and Python are examples of scripting languages.  
-- Source - <http://www.webopedia.com>

Further, at col. 6, lines 31-54, Eintracht teaches only that textual notes can be attached to the different documents types, and nowhere teaches or suggests the use of a sequence of instructions (i.e., a scripting language as recited by present claim 39) for generating collaborative content including a base document and at least one collaborative content element as recited by claim 23 from which claim 39 depends.

Claim 23 – “A system for network collaboration using embedded annotation and rendering instructions comprising: a processor for receiving and transmitting data; and a memory coupled to the processor, said memory having stored therein **sequences of instructions** which, when executed by said processor, cause said processor to generate a collaborative content including a base document and at least one collaborative content element, render the collaborative content, and transmit the collaborative content between client workstations. “

Claim 39- “The system as claimed in claim 23 wherein said **sequences of instructions** include at least one of a client-side scripting language.”

The page description language taught by the Eintracht reference is not the same as the client-side scripting language recited by present claim 39.

**Claim 40**

The Office Action alleges

*“Eintracht discloses wherein said sequences of instructions include at least one of JavaScript and dynamic HTML (page description language, col. 6, lines 31-54, col. 9, line 28-30).”*

I disagree with the Examiner’s allegation that the recited limitation of present claim 40 is the same as the cited teachings of Eintracht.

As noted above, at col. 6 lines 31-54, Eintracht teaches the use of a page description language to describe documents. However, Eintracht nowhere teaches or suggests the use of a page description language to describe notes (collaborative content element) because notes are not taught as embedded in collaborative content included in transmitted messages by Eintracht and there would be no need to use a page description language to describe them. Eintracht only teaches that notes are stored as text and managed and transmitted from server to client separately from documents (i.e., not embedded in a collaborative content as a collaborative content element) and are associated with a location in a document using an (X,Y) coordinate (Eintracht teaches that *“the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document”* (col. 2, lines 50-53)). Eintracht even teaches that the location of a note (the (X,Y) coordinate of the note) can be changed by a user.

Further, Eintracht teaches that a client-side application or web browser plug-in layers notes over a document image, which client-side application or plug-in is not a page description language. PDLs describe how document pages are to be displayed by embedding tags in the text of the document pages. The client-side application and plug-in taught by Eintracht is not taught as a page description language processor. Further, nowhere does Eintracht teach or suggest transmitting the collaborative content between client workstations, as recited by present claim 40.

Therefore, for all these reasons, the teaching by Eintracht of a page description language for expressing a document is not the same as the recited sequences of instructions of claim 39 that

*“when executed by said processor, cause said processor to generate a collaborative content including a base document and at least one collaborative content element, render the collaborative content, and transmit the collaborative content between client workstations, wherein said sequences of instructions include at least one of Javascript and dynamic HTML.”*

At col. 9, lines 28-30 Eintracht teaches the use of Java, which is not the same as a client-side scripting language recited by present claim 39, regardless of whether or not Java is resident on the server to trigger the plug-in on the client side to request a notes update from the server.

#### **Claim 41**

The Office Action alleges

*“Eintracht discloses a client system for network collaboration comprising: a collaborative content (see abstract); and a graphical collaboration tool for generating (fig 3, col. 6, lines 31-54), transmitting (col. 2, lines 8-55), and rendering said collaborative content (col. 2, lines 8-55) wherein said graphical collaboration tool is downloaded from a server (plug-in, fig 3, col. 8, lines 24-43).”*

I disagree with the Examiner's allegations that the recited limitations of present claim 41 are the same as the cited teachings of Eintracht.

At FIG.3, Eintracht teaches a system for using textual notes in the context of a collaboration process which is not the same as a graphical (i.e., drawing) collaboration tool as recited by present claim 41.

At col. 2, lines 8-55, Eintracht teaches a client software application functions to display the document (text) that the user wishes to annotate and provides the tools necessary to permit the user to create, edit, retrieve and store notes (defined by Eintracht as text, see definition above). Eintracht further teaches that the client software application can be implemented as a web browser plug-in module and it should be noted that Eintracht nowhere teaches or suggests that a plug-in or client software application is downloaded from a server. Therefore, neither teaching of Eintracht is the same as the graphical collaboration tool **downloaded from a server** as recited by present claim 41.

#### **Claim 42**

The Office Action alleges

*Eintracht discloses wherein said collaborative content is referencable by a URL (col. 4, lines 13-37)."*

I disagree with the Examiner's allegation that the recited limitation of present claim 42 is the same as the cited teaching of Eintracht.

As argued repeatedly above, Eintracht does not teach a collaborative content including a base document (document) and one or more collaborative content elements (notes).

At col. 4, lines 13-37 Eintracht teaches making separate requests, first for a document, and then for each of any associated notes, where **each request utilizes a separate URL**. Therefore, Eintracht's teaching of using multiple URLs is not the same as the single URL recited by present claim 42 to reference the collaborative content that is comprised of a base document and one or more collaborative content elements.



#### **Claim 43**

The Office Action alleges

*"Eintracht discloses wherein said graphical collaboration tool includes a client-side scripting language (page description language, col. 6, lines 31-54)."*

I disagree with the Examiner's allegation that the recited limitation of present claim 43 is the same as the cited teaching of Eintracht.

As discussed above with respect to claim 39, Eintracht teaches a page description language which is not the same as a scripting language (client-side or otherwise) as recited by present claim 43.

#### **Claim 44**

The Office Action alleges

*"Eintracht discloses wherein said graphical collaboration tool includes at least one of Javascript and dynamic HTML (page description language, col. 6, lines 31-54)."*

I disagree with the Examiner's allegation that the recited limitation of present claim 44 is the same as the cited teaching of Eintracht.

For the same reasons as stated above with regard to claim 40, the page description language taught by Eintracht is not the same as either one of Javascript and dynamic HTML.

#### **Claim 45**

The Office Action alleges

*"Eintracht discloses wherein said collaborative content includes a URL of a base document and a representation of a collaborative content element (fig 5, col. 4, lines 13-38)."*

I disagree with the Examiner's allegation that the recited limitation of present claim 45 is the same as the cited teachings of Eintracht.

At FIG. 5, Eintracht teaches using a URL to identify a folder.

At col. 4, lines 13-38, Eintracht teaches the use of a first URL to identify a request for a document and the use of a second URL to request notes related to the document.

In neither reference does Eintracht teach that

*“collaborative content includes a (single) URL of a base document and a representation of a collaborative content element.”*

Therefore, the two URLs taught by Eintracht is not the same as the single URL recited by claim 45.

#### **Claim 46**

The Office Action alleges

*“Eintracht discloses wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to add a collaborative content element, transmits a representation of the collaborative content element and the URL of said collaborative content to a server and receives from the server said collaborative content including the added collaborative content element (see abstract, fig 5, col. 6, lines 31-54).”*

I disagree with the Examiner’s allegations that the recited limitations of present claim 46 are the same as the cited teachings of Eintracht.

As argued above at least with regard to claim 17, Eintracht nowhere teaches or suggests a graphical (i.e., drawing) collaboration tool to add a collaborative content element. Fig. 5 teaches initialization of a collaboration session between a client and a server and does not teach transmission by a collaboration tool (graphical or otherwise) located at a client of an added collaborative content element or receipt from a server by a client of collaborative content including an added collaborative element. At col. 6, lines 31-54 Eintracht teaches the transmission of **separate** URLs for the purpose of obtaining documents and associated notes. Also, as argued repeatedly above, a server does not layer the notes over an image of the document, but the document and notes are transmitted to a client in separate data streams and a client side application software or plug-in performs this layering of notes over the image of a document.

That is, Eintracht nowhere teaches or suggests in response to a user adding a collaborative content element, a representation of the collaborative content element and a URL of a collaborative content is transmitted to a server by a client and the client then receives from the server the collaborative content including the added collaborative content element.

The graphical collaboration tool recited by claim 46 is not the same as the system for collaborative document annotation taught by Eintracht in the abstract, the initialization of a client session taught in fig 5, or the separate URLs taught at col. 6, lines 31-54.

#### Claim 47

The Office Action alleges

*“Eintracht discloses wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to modify a collaborative content element, transmits a representation of the collaborative content element and the URL of said collaborative content to a server and receives from the server said collaborative content including the modified collaborative content element (see abstract, fig 5, col. 6, lines 31-54).”*

I disagree with the Examiner's allegations that the recited limitations of present claim 47 are the same as the cited teachings of Eintracht.

As argued above at least with regard to claim 17, Eintracht nowhere teaches or suggests a graphical (i.e., drawing) collaboration tool to modify a collaborative content element. Fig. 5 teaches initialization of a collaboration session between a client and a server and does not teach transmission by a collaboration tool (graphical or otherwise) located at a client of a modified collaborative content element or receipt from a server by a client of collaborative content including a modified collaborative element.

At col. 6, lines 31-54 Eintracht teaches the transmission of **separate** URLs for the purpose of obtaining documents and associated notes. Also, as argued repeatedly above, a server does not layer the notes over an image of the document, but the document and

notes are transmitted in separate data streams to a client and a client side application software or plug-in performs this layering of notes over the image of a document.

That is, Eintracht nowhere teaches or suggests in response to a user modifying a collaborative content element, a representation of the collaborative content element and a URL of a collaborative content is transmitted to a server by a client and the client then receives from the server the collaborative content including the modified collaborative content element.

The graphical collaboration tool recited by claim 46 is not the same as the system for collaborative document annotation taught by Eintracht in the abstract, the initialization of a client session taught in fig 5, or the separate URLs taught at col. 6, lines 31-54.

#### **Claim 48**

The Office Action alleges

*"said graphical collaboration tool includes a toolbar (Graphical user interface, col. 6, lines 31-54)"*

I disagree with the Examiner's allegation that the recited limitation of present claim 48 is the same as the cited teaching of Eintracht.

At col. 6, line 66 – col. 7, line 5, Eintracht teaches displaying in FIG. 1C an image (here of a car) 12 with text annotations 16 layered over the image 12 that are not part of the image itself. There is no teaching or suggestion by Eintracht of a graphical collaboration tool anywhere in the Eintracht reference much less a teaching of a toolbar included therein as alleged by the Examiner.

As argued herein and repeatedly above, Eintracht nowhere teaches a graphical collaboration tool and the user interface taught at col. 6, lines 31-54 alleged to be a graphical user interface or GUI by the Examiner is not the same as the recited graphical collaboration tool including a toolbar of claim 48.

**Claim 49**

The Office Action alleges

*"the toolbar includes an add circle tool, an add rectangle tool, an add arrow tool, an add text tool, and an add text highlight tool (col. 17, lines 45-64)"*

I disagree with the Examiner's allegation that the recited limitation of present claim 49 is the same as the cited teaching of Eintracht.

At col. 17, lines 45-64, Eintracht teaches that a note can have a shape other than a rectangle and can have a note shape line cap field, the latter not being explained by Eintracht. Nowhere in Eintracht, either at the cited location or elsewhere is there a teaching or even a suggestion of a toolbar that includes an add circle tool, an add rectangle tool, an add arrow tool, an add text tool, and an add text highlight tool.

The Examiner's cited teaching of Eintracht of a note data structure FIG. 11 that includes a note shape field 220 and note shape cap field 228 is not the same as the graphical toolbar recited by claim 49 that includes an add circle tool, an add rectangle tool, an add arrow tool, an add text tool, and an add text highlight tool and further this teaching of Eintracht does not make such a graphical toolbar inherent in the teachings of Eintracht since the shape of a note can be selected from a drop-down list and is not the same as adding a circle, rectangle, etc. as a collaborative content element to a displayed document by using a toolbar.

**Claim 50**

The Office Action alleges

*"the toolbar includes a collaborative content element name entry field (col. 17, lines 17-19)"*

I disagree with the Examiner's allegation that the recited limitation of present claim 50 is the same as the cited teaching of Eintracht.

At col. 17, lines 17-19, Eintracht teaches that note data structure includes an automatically generated note serial number 212 that uniquely identifies a note and that the note serial number is set to zero for a new note and set to a non-zero value for an

existing note. This is not a teaching of a toolbar that includes a collaborative content element name entry field but of the automatic numbering of notes associated with a document. Nowhere in Eintracht, either at the cited location or elsewhere is there a teaching or even a suggestion of a toolbar that includes a collaborative content element name entry field.

The Examiner's cited teaching of Eintracht of a note data structure FIG. 11 that includes a note serial number field 212 is not the same as the graphical toolbar of recited by claim 50 that includes a collaborative element name entry field.

### **Claims 51 and 52**

The Office Action alleges

*"Eintracht discloses wherein said collaborative content received from the server includes an HTML page (col. 6, lines 31-54, col. 5, line 40)"*

I disagree with the Examiner's allegation that the recited limitation of present claims 51 and 52 is the same as the cited teachings of Eintracht.

At col. 6, lines 31-54, Eintracht teaches that a web server stores notes associated with a document and that the documents and associated annotations are treated independently from each other using separate data structures so that they can be managed independently of one another. At the cited location of col. 6, lines 31-54, Eintracht teaches

"A web server functions to capture special request from one or more client applications for creating, storing, editing and retrieving annotations related to specific documents located in the server. A notes server functions to log all annotation activities along with information about the correspond clients that create, edit and retrieve them."

However, Eintracht teaches that documents and notes are sent in separate data streams by the server to a client and the client layers the notes of the image of the document

"the client software application functions to display the document that the user wishes to annotate and provides the tools necessary to permit the user to create, edit retrieve and store notes (col. 7, lines 34-37) ... In accordance with the invention, the annotations are transmitted from the server independent of the data transmitted that is related to the viewed

document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each (col. 2, lines 50-55)."

Nowhere in the Eintracht reference does Eintracht teach or suggest

*"said collaborative content received from the server includes an HTML page."*

The only reference to HTML in the entire Eintracht reference is in a table of definitions at col. 5, line 40.

The Examiner's cited teachings of Eintracht of a definition of HTML at col. 5, line 40 and of a client-server architecture that includes a web server at col. 6, lines 31-54 is not the same as

*"...the collaborative content received from the server includes an HTML page"* recited by present claims 51 and 52.

### **Claim 53**

The Office Action alleges

*"Eintracht discloses a server system for network collaboration comprising: a collaborative content (see abstract); and a server process for responding to a user request wherein the user request includes at least one of a request for said collaborative content (col. 2, lines 8-67, col. 3, lines 12-36), a graphical collaboration tool (fig 3, col. 6, lines 31-54), said collaborative content including an added collaborative content element (col. 2, lines 8-67), and said collaborative content including a modified collaborative content element (abstract, col. 3, lines 5-67)."*

I disagree with the Examiner's allegations that the recited limitations of present claim 53 are the same as the cited teachings of Eintracht.

In the Abstract Eintracht teaches a client-server architecture for collaborative document annotation wherein the server maintains documents and associated annotations separately and not as a collaborative content.

At col. 2, lines 8-67, Eintracht teaches a web server that stores documents separate from associated annotations and not as a collaborative content and teaches that "Separate data structures are created for the documents and for the associated annotations thus permitting their independent management (col. 2, lines 12-15)."

At col. 3, lines 12-36, Eintracht again teaches

“a document file located on a server, the document file for storing one or more documents, a notes database located on the server, the notes database for storing one or more notes, each note associated with a particular document ... the notes server operative to store the documents in the document file separately from notes stored in the notes database...”

which is not the same as the recited “server system comprising a collaborative content” of present claim 53 because it teaches separate files that are maintained and managed separately by a server and nowhere teaches or suggests a collaborative content as recited by the present claimed invention. As repeatedly argued above, an application software at a client side creates a layered display from document and annotation data transmitted in separate data streams by a server from separately maintained document and notes databases at the server and Eintracht teaches such client application software at least at col. 2, lines 34-40 and col. 2, lines 53-55.

At FIG. 3, Eintracht teaches a client-server architecture for a document collaboration system and nowhere teaches or suggests a server comprising a graphical collaboration tool as recited by present claim 53. At col. 6, line 31-54, Eintracht teaches a client-server system for collaborative document annotation having a user interface but nowhere teaches or suggests a server comprising a graphical collaboration tool as recited by present claim 53.

At col. 2, lines 8-67 Eintracht teaches *inter alia*

“A synchronization button is provided which, when pressed by the user, transmits the annotations generated by the user from the client to the server using a particular protocol. In response, the server transmits back an acknowledgement along with any new notes that other clients may have posted since the last synchronization was performed.”

Eintracht is not teaching the server receiving a request for collaborative content from a client but is teaching a client sending notes to the server and receiving new notes posted to the server by other clients in return. Therefore, the cited teaching of Eintracht is not the same as the recited limitation of present claim 53 of a request by a client for a collaborative content but is a teaching by Eintracht of a client sending collaborative content elements (e.g., a note) to the server and receiving only collaborative content



elements (new notes) from the server. While in the Abstract and at col. 3, lines 5-67, Eintracht arguably teaches a server sending added and updated notes to a client these notes, in and of themselves, are collaborative content elements only and as such are not the same as the

“collaborative content including an added collaborative content element and modified collaborative content element”

as recited by present claim 53.

#### **Claim 54**

The Office Action alleges

*“Eintracht discloses wherein said collaborative content is referencable by a URL (col. 4, lines 13-37).”*

I disagree with the Examiner’s allegation that the recited limitation of present claim 54 is the same as the cited teaching of Eintracht.

As repeatedly argued above, Eintracht does not teach a collaborative content and therefore cannot teach that a collaborative content is referencable by a URL.

At col. 4, lines 13-37, Eintracht teaches

“...a method of annotating documents, the method comprising the steps of getting a first request comprising a URL associated with a document to be viewed and annotated and transmitting the first request from a client to a server...”

A document alone is not a collaborative content as recited by claim 54 and therefore the cited teaching of Eintracht is not the same as the recited URL of present claim 54.

#### **Claim 55**

The Office Action alleges

*“Eintracht discloses wherein said server process is a CGI script (col. 30, lines 31-54).”*

At the outset it is assumed that the Examiner meant col. 6, lines 31-54 and not col. 30, lines 31-54 since there is not column 30 in the Eintracht reference.

I disagree with the Examiner’s allegation that the recited limitation of present claim 55 is the same as the cited teachings of Eintracht.

Eintracht teaches a general description of a system for collaborative document annotation at col. 6, lines 31-54 but nowhere in the Eintracht reference either teaches or suggests a server process is a CGI script. Therefore the teaching of Eintracht at col. 6, lines 31-54 is not the same as the recited limitation of present claim 55 since there is no teaching of a CGI script at the cited location or anywhere else in Eintracht.

#### **Claim 56**

The Office Action alleges

*“Eintracht discloses wherein said collaborative content includes a URL of a base document and a representation of a collaborative content element (col. 4, lines 13-37).”*

I disagree with the Examiner’s allegation that the recited limitation of present claim 56 is the same as the cited teaching of Eintracht.

As repeatedly argued above, Eintracht does not teach a collaborative content of any kind and at col. 4, lines 13-38, Eintracht teaches a first URL to identify a request for a document and a second URL to request notes related to the document which is not the same as the recited limitation of present claim 56 that said collaborative content includes a URL of a base document and a representation of a collaborative content element (including an embedded representation of a note).

#### **Claim 57**

The Office Action alleges

*“Eintracht discloses said server process (claim 53) executes on a client workstation of a user (col. 2, lines 34-67).”*

I disagree with the Examiner’s allegation that the recited limitation of present claim 57 is the same as the cited teaching of Eintracht.

At col. 2, lines 34-67 Eintracht teaches separate client and server-side functions and a web server for storing documents and annotations and a web server application on the server side. Eintracht also teaches at the cited location, a notes server logs all annotation activities and that a portion executes on a server and a portion executes on a

client. However, nowhere at the cited location or anywhere else does Eintracht teach or suggest that

*“the server processes recited by claim 53 executes on a client workstation of a user.”*

Therefore, the teaching of the cited reference is not the same as the recited limitation of present claim 53.

#### **Claim 58**

The Office Action alleges

*“Eintracht discloses wherein said collaborative content transmitted in response to a user request includes an HTML page (col. 6, lines 31-54, col. 5, line 40).”*

I disagree with the Examiner’s allegation that the recited limitation of present claims 58 is the same as the cited teachings of Eintracht.

At col. 6, lines 31-54, Eintracht teaches that a web server stores notes associated with a document and that the documents and associated annotations are treated independently from each other using separate data structures so that they can be managed independently of one another. At the cited location, Eintracht teaches

*“A web server functions to capture special request from one or more client applications for creating, storing, editing and retrieving annotations related to specific documents located in the server. A notes server functions to log all annotation activities along with information about the correspond clients that create, edit and retrieve them.”*

However, Eintracht teaches that documents and notes are sent in separate data streams by the server to a client and the client layers the notes of the image of the document

*“the client software application functions to display the document that the user wishes to annotate and provides the tools necessary to permit the user to create, edit retrieve and store notes (col. 7, lines 34-37) ... In accordance with the invention, the annotations are transmitted from the server independent of the data transmitted that is related to the viewed document. At the client side, the client application layers the annotations over the image (or document) in accordance with the coordinates of each (col. 2, lines 50-55).”*

None of which is a teaching of an HTML page as recited by present claim 58.

Further, nowhere in the Eintracht reference does Eintracht teach or suggest a

*"server wherein said collaborative content transmitted in response to a user request includes an HTML page."*

The only reference to HTML in the entire Eintracht reference is in a table of definitions at col. 5, line 40.

The Examiner's cited teachings of Eintracht of a definition of HTML at col. 5, line 40 and of a client-server architecture that includes a web server at col. 6, lines 31-54 is not the same as

*"...a server wherein said collaborative content transmitted in response to a user request includes an HTML page"*

recited by present claim 58.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful statements may jeopardize the validity of the application or any patent issuing thereon.

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TED FRIEL

*Ted Friel*

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DATE

4-7-05

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AL BLANCHETTE

*Al Blanchette*

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DATE

4-7-05

APPENDIX C - Related Proceedings

N/A